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IN THE

Supreme Court of the United States

October Term, 1949.

No. 8[redacted] 74

GEORGE R. ERICSON and CARTER CARBURETOR CORPORATION,

v.

Petitioners,

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

No.

OTTO HENNING and CARTER CARBURETOR CORPORATION,

v.

Petitioners,

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

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PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioners, George R. Ericson and Carter Carburetor Corporation (hereinafter called "Carter"), in No.

———, and your Petitioners, Otto Henning and Carter Carburetor Corporation, in No. ———, respectfully pray for writs of certiorari to the United States Court of Appeals for the Eighth Circuit to review two separate judgments of that Court—one in each action—upon a single record. Petitions for rehearing were denied March 31, 1950.

Transcript of the record below, including the proceedings in the said Court of Appeals, is furnished herewith in accordance with the rules of this Court.

Opinions Below.

The opinions or decisions of the Board of Interference Examiners, both originally and upon rehearing, are printed at R. II, 463,[1] 481;[2] on petition for consideration at R. II, 485[3] and 487;[4] the opinion in the District Court at R. I, 57[5] and 110.[6] They are reported in 81 F. Supp. 614 and 621. The opinions of the Court of Appeals are printed at R. III, 1043[7] and 1044.[8] They are reported in 180 F. 2d 180 and 353. The judgments of the Court of Appeals are printed at R. III, 1053[9] and 1054.[10] Its orders denying the petitions for rehearing are printed at R. III, 1089[11] and 1090.[12]

All of the foregoing, R. S. § 4904[13] (35 USC § 52), R. S. § 4915[14] (35 USC § 63), PX 22[15] and the counts[16] or claims involved in these actions, are set out in the appendix hereto.

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(1) Printed in Appendix hereto at page 9.
(2) Printed in Appendix hereto at page 21.
(3) Printed in Appendix hereto at page 23.
(4) Printed in Appendix hereto at page 18.
(5) Printed in Appendix hereto at page 52.
(6) Printed in Appendix hereto at page 38.
(7) Printed in Appendix hereto at page 61.
(8) Printed in Appendix hereto at page 53.
(9) Printed in Appendix hereto at page 64.
(10) Printed in Appendix hereto at page 63.
(11) Printed in Appendix hereto at page 66.
(12) Printed in Appendix hereto at page 65.
(13) R. S. § 4904 (35 USC § 52), printed in Appendix hereto at page 2.
(14) R. S. § 4915 (35 USC § 63), printed in Appendix hereto at page 2.
(15) PX 22, printed in Appendix hereto at page 7.
(16) Counts involved, printed in Appendix hereto at pages 3, 5.

Summary and Short Statement of the Matter Involved.

These actions were instituted by respondents in the United States District Court, Eastern District of Missouri, to obtain judgments authorizing the Commissioner of Patents to issue a patent having one claim for which the Board of Interference Examiners in the Patent Office, in an interference between the Jorgensens and Ericson, had unanimously awarded priority of invention to Ericson, and for the five claims for which that Board, in another interference between the Jorgensens and Henning, had unanimously awarded priority of invention to Henning.

In their complaints filed April 29, 1946 (R. I, 1 and 14) respondents alleged jurisdiction under R. S. § 4915 (35 USC § 63) as amended in 1927 and 1929. By leave of Court the complaints were amended (R. I, 11 and 24) June 2, 1947 by adding "and as amended August 5, 1939 (53 Stat. 1212)."

The District Court overturned the decisions of the Patent Office, awarded priority of invention to the Jorgensens for the subject-matter of all six counts or claims, and entered a judgment in each action authorizing the issuance of a patent for the claim or claims involved to General Motors Corporation, the Jorgensens' assignee. Upon appeal those judgments were affirmed January 26, 1950 by the Court of Appeals for the Eighth Circuit. Rehearing was denied March 31, 1950 in each action.

The device called for by each of those counts is commonly known as an automatic choke for carburetors[17] for automobiles.

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(17) A carburetor is a device for mixing therein, in proper proportions, air and fuel for combustion in the cylinders of an internal combustion engine. It has an air inlet and a fuel inlet or inlets. The mixture is drawn by suction from the carburetor to the cylinders through a pipe—the intake manifold—having branches connected with the several cylinders. The proportioning of the air and fuel in the carburetor can, of course, be accomplished by keeping either the air or the fuel intake constant while controlling the amount of the intake of the other. The extent of the suction, or reduction in pressure, in the intake manifold by the movement of the pistons in the cylinders of the engine when it is being cranked or is running, depends upon the extent to which the inlets to the carburetor are closed or diminished in size; the more nearly they are closed the greater is the suction. (R. I, 153-155.)

Writs of certiorari are here sought by petitioners, Ericson and "Carter", his assignee, and Henning and "Carter", his assignee, in that the Courts overthrew the decisions of the Patent Office (a) without having before them the entire records upon which that Executive Department of the Government made its decisions; (b) notwithstanding the Jorgensens, if they made a reduction to practice in 1928-1929, as held by the District Court or the winter of 1929-1930, as held by the Court of Appeals deliberately and without excuse postponed, it is believed, the beginning of the term of their monopoly until the demand for automatic chokes should be at flood (R. I, 265), thus putting off the free public enjoyment of their invention and defeating the aim, purpose and intent of the patent laws; (c) by subverting, it is submitted, the doctrine of *Morgan v. Daniels*, 153 U. S. 120, by assigning to meager oral evidence with respect to some alleged test or tests of the Jorgensens' devices, given almost a score of years after the alleged tests, a weight overbalancing all the contemporaneous documents which refute, it is believed, that oral evidence; (d) by finding that the Jorgensens conceived and reduced to practice their alleged invention at a time when the contemporaneous documents establish they had no definite and permanent idea of the elements or means necessary to accomplish their objective; and (e) notwithstanding the Jorgensens' application does not disclose the device relied upon by respondents to establish conception and reduction to practice prior to the filing date of the Jorgensens' application.

The patent so authorized by the Court below would shackle the public at large with a monopoly in favor of General Motors Corporation for a period of 17 years after the expiration on June 27, 1950 of one patent monopoly--Patent Re. No. 22,742 which issued to Carter as Ericson's assignee—for the subject-matter of the count involved in the action against Ericson and Carter. The patent so authorized by the Court below would shackle the public at

large with a further monopoly in favor of General Motors Corporation for a period of at least 3 years after June 3, 1964, the expiration date of the patent issued to Carter as assignee of Henning.

The Board of Interference Examiners held that Ericson's record before the Board established "conception of the invention in issue not later than the fall of 1929, but no reduction to practice prior to his filing date" (R. II, 477). Ericson filed on April 24, 1930 (R. II, 813) an application upon which Patent No. 1,915,852 issued June 27, 1933 (R. II, 823).* He filed another application, a continuation-in-part of the former, on November 6, 1931 which resulted, also on June 27, 1933, in Patent No. 1,915,851 (R. II, 835). That patent was reissued April 9, 1946, as Re. No. 22,742 upon Ericson's application filed therefor December 30, 1940 (R. II, 863). Figs. 1 and 3 of Patent No. 1,915,852 which depict Ericson's device are the same as Figs. 10 and 12 of Patent No. 1,915,851, and Figs. 10 and 12 of Re. No. 22,742. In the trial court Ericson presented evidence, both documentary and oral (R. II, 725-767, 775-805; R. I, 436-438), showing diligence from his conception in October 1929 until his filing date of April 24, 1930.

Even if the decision of the Court below, made in its original opinion and adhered to after reconsideration, holding that the Jorgensens conceived and reduced to practice in the winter of 1929-1930 the subject-matter of the counts here involved be sound, it does not follow that the Patent Office made a mistake in awarding priority of invention to Ericson.

Henning's application was filed November 17, 1931; Patent No. 2,421,733 issued thereon June 3, 1947 (R. II, 905). He assigned to Carter. They claim no date earlier than his filing date for his conception or reduction to practice.

The Jorgensens' application was filed January 8, 1932 (R. II, 931, 1021, 1025).

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* Smith v. Carter Carburetor Corp., 130 F. 2 555 (CCA 3).

As plaintiffs in these actions, respondents asserted that the Jorgensens conceived and reduced to practice in 1928-1929 and in the winter of 1929-1930 the invention of each of the six claims here involved; that their device was first attached to a Schebler carburetor on a Studebaker car which Dole Valve Company acquired from the Studebaker Corporation at a discount for the Jorgensens' experiments; that they experimented with the Jorgensen-Schebler combination from the fall of 1928 until just before Christmas 1929; that they then replaced the Schebler carburetor and its manifold on the Studebaker car with a Stromberg carburetor and its manifold and experimented with that Jorgensen-Stromberg combination until about the first of August 1930; that they then removed their Jorgensen-Stromberg combination and its manifold from the Studebaker car and replaced thereon the Schebler and its manifold, and returned the car to Dole. The Jorgensens made no further experiments (R. I, 120).

Mr. Jorgensen testified (R. I, 201):—

> "There is no difference at all between the Schebler carburetor and the Stromberg as far as this unit—the automatic choke unit is concerned."

Photographs of the Jorgensen device are shown at R. II, 501 and 503.

Mr. Jorgensen testified (R. I, 187) that they were trying to make "a fully automatic device so there would be no attention on the part of the operator necessary at all"; that (R. I, 188) "what we were trying to do was to *find means* that would sense the requirements necessary to *start*[18] and *run* an automobile engine, particularly when cold, entirely automatically"; and that "*Starting requirements are quite different from running*" (R. I, 188).

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(18) Emphasis throughout the petition is petitioners' unless otherwise noted.

As appears from its amended opinion (R. I, 121), the District Court found that the Jorgensens conceived and reduced to practice their alleged invention in 1928 and 1929.

The Court of Appeals found (R. III, 1050) that the Jorgensens conceived their device and reduced it to practice in "the winter of 1929 and 1930".

When Mr. Jorgensen was asked the reason for the delay from the time of his asserted reduction to practice to the date he filed his application, this was his answer (R. I, 265):

> "A. Because we were—As we have explained before, our connection with Dole—my father handled the manufacture of his water-line thermostats, priming devices and several other things, and we had built up, during a period of three or four years, a great deal of business. So that, what time we had to do *additional experimental* work had to be—I was burning the candle at both ends, and although we were very much interested in this subject, *we just didn't have the physical time to put as much time on that as we would like, and in addition to that,* I found in making contacts with the automobile manufacturers that *the trade wasn't ready to spend money for an automobile coke* (sic). But *we kept our development work in mind and kept it coming along to the time when there would be a commercial market.* I don't think you could have sold an automatic choke prior to 1929, 1930 or 1931, regardless of how good it might have been, because they were not interested in automatic starting devices at that time." [19]

At the very time that their experiments were laid aside, Mr. C. H. Jorgensen wrote in his own handwriting (R. I, 230) a memorandum dated August 2, 1930, stating: (R. II, 507-509)

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(19) That statement by one of the alleged inventors evinces either that their experiments had not been completed—their device had not been reduced to practice—or they had deliberately delayed filing their application until demand for automatic chokes should be at flood. Delay for such purpose is an abuse of the patent laws and bars or invalidates a patent for the alleged device. *Woodbridge v. United States,* 263 U. S. 50, 56.

"Our first developments have centered largely around the three fundamentals in carburetion i. e. Temperature, Manifold depression and air velocities. By using in series a mechanical hook-up of a thermostat metal coil a bellows operated from manifold depressions and an unbalanced air valve we have able to get very satisfactory operation *after initial starting.*

"Because of the unbalance air choke valve used *it is necessary* to hold or retard the choke valve during the cranking period and we have employed several different methods.

"In that manifold depression tends to open the choke valve in our system the valve is positioned in its extreme close position for given temperatures which has been worked out to give the right amount of choke for such given temperatures *thus making it only necessary to hold or retard the choke valve in such position while cranking. One method used is an electrical solenoid* attached to the air horn in such a way when the electric circuit is completed the choke valve becomes locked in its given position at such instant. The solenoid is connected in series with the ignition and starter switches making it impossible to choke unless both switches are in contact. This also provides means for cranking the engine without choking which is necessary in cases of flooding by simply turning off the ignition.

"In place of using the solenoid we have also used a dash pot connected to the choke valve."

Dated the same day—August 2, 1930—and notarized by the Jorgensens themselves on August 12, 1930, is a drawing (PX 22, R. II, 531). That drawing shows a rod leading to the dashboard of the car (R. I, 232-3) by which *to control manually the position of the choke valve* through *manual control of the device* asserted by respondents to have been

previously and successfully reduced to practice as a fully automatic device.[20]

Still another contemporaneous document, DX 45, being the report by Studebaker of a test on "Jorgensen automatic choke in cold room on Jorgensen car" on 12/19/31 is confirmatory of Mr. Jorgensen's statement in his memorandum of August 2, 1930, that his so-called automatic choke was satisfactory only "after initial starting", in that DX 45 states:

> "Started by dyn. [dynamometer] *after failing to start after one min. cranking.* Choke valve would lift slightly off seat when cranking."

Although Mr. Jorgensen testified (R. I, 272-3) that that was another unit, he did not say that it differed in any respect from the device relied upon by respondents for conception and reduction to practice prior to the Jorgensens' filing date of January 8, 1932.

When, at the beginning of August 1930, their experiments were laid aside and abandoned the Jorgensens, even then, had no definite and permanent idea of the elements or means necessary to accomplish their objective (PX 14 and PX 22). The device of the Jorgensens' application includes no dash pot or equivalent. The "kicker" of their application finds no antecedent in their experimental device (R. III, 1049).

In their application the Jorgensens have presented to the Patent Office 124 claims. The claims involved in the action against Henning and Carter are Nos. 89, 90, 91, 92 and 94 of that application. Claim 89 was not filed until November 4, 1939 (R. II, 1025). The other 4 claims were presented by amendment on March 11, 1941. The single

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(20) In *United States v. Gypsum Co.*, 333 U. S. 364, 395-396, this Court after holding that the findings of the lower tribunal are "never conclusive", said, with respect to oral evidence:

> "Where such testimony is in conflict with contemporaneous documents we can give it little weight, particularly when the crucial issues involve mixed questions of law and fact."

count in the action against Ericson and Carter is the 95th claim of that application filed January 27, 1943 (R. II, 1035).

Not all the evidence upon which the Patent Office relied in holding that the Jorgensens had "neither established conception, nor reduction to practice of any of the devices relied upon prior to Henning's filing date, [which was subsequent to Ericson's], nor diligence in reducing to practice during the critical period" was presented to the Courts below [21] (R. I, 274 and 460).

In the trial Court, respondents called two witnesses—Paton and Williams—not produced as witnesses in the Patent Office interferences. They were available and their testimony could have been obtained for submission in those interferences (R. I, 115). No sufficient reason appears (R. I, 221 and 326, 331) why they were not called as witnesses in the interferences if respondents believed they had any knowledge or information of weight or significance.[22]

Paton saw a Jorgensen-Schebler combination once, and but once (R. I, 319, 332). He said the engine made a "perfectly normal start" (R. I, 321). He never saw any experiments with the Jorgensen-Stromberg combination (R. I, 326) upon which the Court of Appeals rested its decision (R. III, 1050).

Williams was a garage attendant where Jorgensen kept his Studebaker car. He said that when the engine equipped with the Jorgensen-Schebler combination was started the valve would flutter, wouldn't hold steady every time he saw it (R. I, 306). That meant that the valve would open when it should have remained closed and is confirmatory of PX

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(21) In the absence of any part of the record before the Patent Office, it would seem impossible for the Courts to hold that the Patent Office was mistaken in its conclusions and that consequently the action would have to be dismissed upon the doctrine of *Morgan v. Daniels*, 153 U. S. 120. That is apparently the ruling in *Victor Talking Mach. Co. v. Brunswick-Balke-Collender Co.*, 8 F. 2d 41, which under authority of *Morgan v. Daniels* was affirmed 273 U. S. 670; *Miss. Valley Barge Co. v. U. S.*, 292 U. S. 282; *Buck v. Ooms*, 63 F. Supp. 715.

(22) The effect therof and the applicable law is stated in *Boucher Inventions v. Sola Electric Co.*, 131 F. 2d 225 (App. D. C.).

14. Williams was not asked about the Jorgensen-Stromberg combination.

Since the judgments of the Courts below, overturning the decisions of the Patent Office, were made to rest almost entirely upon the oral testimony of Paton, Williams, Kyser and Jorgensen (R. I. 120), that leaves the testimony of Kyser and Jorgensen. Kyser, like Paton, was a Studebaker engineer (R. I, 22). The engineers of that company were interested in automatic chokes (R. I, 197). Kyser saw the Jorgensen-Schebler device, started the car and drove it once (R. I, 352-353); said it was "quick starting" and that he considered the operation "good" (R. I, 354); stated he saw the Jorgensen-Stromberg device and drove the car with it attached; that it worked "very well" and that he considered the device "successful" (R. I, 356-358). But, Paton and Kyser did not deem the tests they saw sufficient to warrant the adoption of the Jorgensen device by Studebaker (R. I, 334, 376-377). Studebaker never did adopt the Jorgensen device. They used that of Stromberg and of Carter (R. I, 375).

Jorgensen! Jorgensen testified (R. I, 203-204) that they used a dash pot on the combination with the Schebler; afterwards found that they didn't need it and never used it in connection with the Stromberg; both combinations worked satisfactorily (R. I, 237, 259, 269). But, PX 14 and PX 22 made when the Jorgensens' experiments were laid aside incompleted (R. I, 265) speak a different language and tell a different story.

Aseltine testified (R. I, 398-399) respecting a test of a Jorgensen device *in 1943* in the presence of opposing counsel. Significantly, he was not asked and he did not state whether the engine had been warmed up or was cold when the "demonstration" began. Such a so-called demonstration would seeminevitably to be suspect and valueless.

Even before the Jorgensens had received or started their experiments with the Stromberg carburetor, (which are the only experiments that may be considered as

against Henning and Carter (R. I, 416)), Ericson had asked Dole (with which the Jorgensens were associated) regarding thermostatic metal. Replying, Dole stated (DX 15-B, R. II, 777):—

> "If you would take us into your confidence and explain to us your problems, we are confident that our engineers can work out a proposition that will satisfy you and satisfy you in a much more satisfactory manner than if we were working entirely in the dark."

Ericson (Carter) did *on December 3, 1929* (DX 15-A, R. II, 775). And, Jorgensen now says (R. I, 228) that he got the Stromberg and its manifold "just before Christmas in 1929".

It would seem clear that the public at large has but little protection against successive monopolies if unanimous decisions of the Board of Interference Examiners may be overthrown and the doctrine of *Morgan v. Daniels* rendered ineffective by meager oral testimony given almost a score of years after the alleged occurrences and in conflict with all the contemporaneous documents.

Jurisdiction.

(a) The statutory provision believed to sustain the jurisdiction of this Court is Title 28, U. S. Code, § 1254.

(b) The date of the judgments which petitioners seek to have reviewed is January 26, 1950 (R. III, 1053 and 1054). Petitions for rehearing were denied March 31, 1950 (R. III, 1089 and 1090). On April 10, 1950 mandates were stayed for a period of 50 days from and after April 10, 1950, and if within that period a petition or petitions for writ of certiorari, record and brief have been filed, the stay granted is to continue until the final disposition of the cases by this Court.

This petition, with the record, is presented May —, 1950.

(c) A case believed to sustain the jurisdiction is *Hiatt v. Brown,* 339 U. S. 103, 106, and Footnote 1.

Questions Presented.

1. May the Courts in actions under R. S. § 4915 (35 U. S. C. § 63) validly overthrow decisions of the Patent Office awarding priority of invention in interference proceedings if, in such actions, the Courts do not have before them the entire record upon which that executive department acted?

2. Does not an inventor lose his right to a patent for his invention if he deliberately and without excuse delays filing a patent application therefor with the intent and "purpose of making the term of his monopoly square with the period when the commercial profit from it would be highest"?

3. Does not long and unexplained delay in filing a patent application for an alleged invention, following tests thereof, raise a presumption and evince that the tests were not successful?

4. Is not the doctrine of *Morgan v. Daniels*, 153 U. S. 120, subverted by acceptance by the courts in actions, under R. S. § 4915 (35 U. S. C. § 63) of meager oral evidence, adduced nearly twenty years after the alleged events, as sufficient to over-balance all contemporaneous documents and acts made and done by the alleged inventors and to overturn the decisions of the Board of Interference Examiners?

5. Under the patent laws, can there be either conception or reduction to practice of an alleged invention in the absence of a definite and permanent idea of the elements or means by which to produce the desired result?

6. May persons who were available and whose testimony could have been but was not obtained for submission to the Board of Interference Examiners in an interference proceeding, testify in an action brought under R. S. § 4915 to overthrow the decision of the Board made in such Interference?

7. Were not Ericson and Henning, respectively, the first inventors of the subject matter of the counts here in issue?

Reasons Relied On for Allowance of the Writ.

(1) In setting aside the decisions of the Board of Interference Examiners of the Patent Office without having before them the complete records upon which those decisions were based, the Courts below acted contrary to decisions of other Courts of Appeals and of this Court in cases involving judicial review of decisions of executive departments of the government.

While an action under R. S. § 4915 is in form a trial *de novo* and not strictly an appeal, nevertheless it is an application to the Court to set aside the action of one of the executive departments of the government. (153 U. S. 124.) The amendments to R. S. § 4915 have not affected the applicability of the doctrine of *Morgan v. Daniels* to actions under that statute; *Abbott v. Coe,* 109 Fed. (2d) 449 (App. D. C.).

It is believed the Courts cannot either accurately or legally determine whether the Patent Office made a mistake unless they have before them for their inspection the entire record upon which the Patent Office acted. That would seem to be the ruling in *Victor Talking Mach. Co. v. Brunswick-Balke-Collender Co.,* 8 F. 2d 41 (CCA 3), affirmed by this Court on the authority of *Morgan v. Daniels* in *Victor Talking Mach. Co. v. Brunswick-Balke-Collender Co. and John Bailey Browning,* 273 U. S. 670. *Buck v. Ooms,* 63 F. Supp. 715 (affirmed but without reference to point here under consideration, 159 F. 2d 462), held that the doctrines of *Miss. Valley Barge Co. v. U. S.,* 292 U. S. 282, *Morgan v. Daniels,* 153 U. S. 120 and *Abbott v. Coe,* 71 App. D. C. 195, 109 F. 2d 449 are as applicable in actions under R. S. § 4915 as in cases involving rulings of other administrative agencies. The contrary decision by the Courts below presents an important federal question which has not been, but should be definitely settled by this Court.

(2) In authorizing the grant of a patent to an alleged inventor who admittedly (R. I, 265) delayed filing his application because of the lack of any commercial demand for the alleged invention at the time the Courts below found it was reduced to practice, those Courts have decided a federal question in a way probably in conflict with the applicable decision of this Court in *Woodbridge v. U. S.*, 263 U. S. 50 and in conflict with *Wirebounds Patents Co. v. Saranac Automatic Mach. Corp.*, 65 F. 2d 904, 906 (CCA 6).

The Courts below have found that the Jorgensens reduced their invention to practice in 1928-1929 or in the Winter of 1929 and 1930. Yet their application for a patent was not filed until January 8, 1932. The claims corresponding to the counts in issue in these actions were not inserted in the Jorgensens' application until various times in 1939, 1941 and 1943. In attempted justification of the delay in filing the application, Mr. C. H. Jorgensen, who testified in this action, said (R. I, 265):

> "* * * The trade wasn't ready to spend money for an automobile choke. But we kept our development work in mind and kept it coming along to *the time when there would be a commercial market.* I don't think you could have sold an automatic choke prior to 1929, 1930 or 1931, regardless of how good it might have been, because they were not interested in automatic starting devices at that time."

In *Woodbridge v. U. S.*, 263 U. S. 50, 56, this Court said:

> "Any practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date of the actual invention, the beginning of the term of his monopoly, and thus puts off the free public enjoyment of the useful invention, is an evasion of the statute and defeats its benevolent aim."

In that case the delay was longer but its motivation was the same—"for the admitted purpose of making the term of the monopoly square with the period when the commercial profit from it would be the highest."

The case at bar affords a striking illustration of the public hardship with which the delay sanctioned by the Courts below is fraught. Patent Re. No. 22,742 to Carter, assignee of Ericson, will expire on June 27, 1950. Claim 14 of that patent is the count or claim in issue in the above-entitled action against Ericson and Carter. The judgment of the Court below authorizes the issuance of a patent containing that count or claim to General Motors Corporation, assignee of the Jorgensens, and, if allowed to stand, will perpetuate the monopoly of such claim for the benefit of General Motors Corporation and at the expense of the public for a further period of seventeen years. It will further extend for a period of at least three years the monopoly that should cease to exist upon the expiration of Patent No. 2,421,733 which issued on June 3, 1947 to Carter as assignee of Henning.

Patents are authorized "To promote the progress of Science and Useful Arts". When properly granted, patents take nothing from the members of the public but confer upon them a benefit. When their grant has a contrary effect, the patent laws have been misused and abused. A patent having that effect should be branded "Unclean and Invalid," not "Rejected by the Patent Office, but Authorized by the Courts".

(3) *Morgan v. Daniels*, 153 U. S. 120, has long marked one of the boundaries of the power and authority of the Courts in actions under R. S. § 4915. Any impairment of that doctrine unsettles the law, postpones the period of the patent monopoly and violates the rights of the public. The doctrine of that case is evaded and subverted if actions under that statute are decided not upon the actions and memoranda of the alleged inventors at the time of

their asserted reduction to practice or shortly thereafter, but upon oral testimony, given almost a score of years after the alleged occurrences and refuted by all the contemporaneous documents. *Electro Metallurgical Co. v. Krupp Nirosta Co.*, 33 F. Supp. 324, 328, affirmed 122 F. 2d 314 (CCA 3).

The decisions below are probably in conflict with those two cases and as well with *United States v. Gypsum Co.*, 333 U. S. 364, 395-396.

(4) The decisions of the Court below are probably in conflict with the decisions of other Courts of Appeals as to whether persons who were available and whose testimony could have been, but was not obtained for submission to the Patent Office in an Interference Proceeding (R. I, 115), may testify in an action brought under R. S. § 4915 (35 U. S. C. § 63) to overthrow the decision of the Patent Office made in that Interference. Cases requiring full disclosure to the Patent Office so far as is reasonably possible, with which the decisions of the Courts below are believed to be in conflict, include *Boucher Inventions v. Sola Electric Co.*, 131 F. 2d 225; *Greene v. Beidler*, 2 Cir., 1932, 58 F. 2d 207, 209; *Barrett Co. v. Koppers Co.*, 3 Cir., 1927, 22 F. 2d 395, 397; *O'Donnell v. United Shoe Machinery Corp.* (D. C., Mass., 1933), 2 F. Supp. 178, 181, cf. *Perkins v. Lawrence Sperry Aircraft Co.* (D. C., E. D. N. Y., 1932), 57 F. 2d 719, 720; *Dowling v. Jones*, 2 Cir. (1933), 67 F. 2d 537, 538; *Wright v. Runge* (D. C., D. C. 1939), 31 F. Supp. 844.

(5) The foregoing reasons are peculiarly applicable to actions under R. S. § 4915 in which conflict of decisions among the circuits can exist only with respect to the legal principles or doctrines applied in such actions.

WHEREFORE, your petitioners respectfully pray that writs of certiorari be issued out of and under the seal of this Court, directed to the United States Court of Appeals for the Eighth Circuit, commanding such Court to certify

and send to this Court, on a day to be designated, a full transcript of the record and all proceedings of the Court of Appeals had in these actions, to the end that these actions may be reviewed and determined by this Court; that the judgments of the Court of Appeals be reversed; and that petitioners be granted such other and further relief as may seem proper.

HUGH M. MORRIS,
Attorney for Petitioners.

GEORGE R. ERICSON,
BERTRAM H. MANN, JR.,
Of Counsel.

Dated: May 12, 1950.

Office - Supreme Court, U. S.
FILED
MAY 15 1950
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1949.

No. 8[redacted] 74

GEORGE R. ERICSON and CARTER CARBURETOR CORPORATION,
Petitioners,
v.
CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,
Respondents.

No. .

OTTO HENNING and CARTER CARBURETOR CORPORATION,
Petitioners,
v.
CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,
Respondents.

APPENDIX TO PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1949.

No. .

GEORGE R. ERICSON AND CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, ADM'R. OF THE ESTATE OF PETER J. JORGENSEN, DECEASED, AND GENERAL MOTORS CORPORATION,

Respondents.

No. .

OTTO HENNING AND CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, ADM'R. OF THE ESTATE OF PETER J. JORGENSEN, DECEASED, AND GENERAL MOTORS CORPORATION,

Respondents.

APPENDIX TO PETITION FOR WRITS OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

STATUTES INVOLVED.

R. S. § 4904 (35 USC § 52).

"§ 52. *Interferences; determination of priority; issue of patent.* Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor. R. S. § 4904; March 2, 1927, c. 273, § 4, 44 Stat. 1336; Aug. 5, 1939, c. 451, § 1, 53 Stat. 1212."

R. S. § 4915 (35 USC § 63).

"§ 63. *Bill in equity to obtain patent.* Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the ap-

plicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. R. S. § 4915; February 9, 1893, c. 74, § 9, 27 Stat. 436; March 2, 1927, c. 273, § 11, 44 Stat. 1336; March 2, 1929, c. 488, § 2(b), 45 Stat. 1476; August 5, 1939, c. 451, § 4, 53 Stat. 1212."

COUNTS INVOLVED.

Counts Involved in Otto Henning and Carter Carburetor Corporation, Petitioners v. Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator of the Estate of Peter J. Jorgensen, Deceased and General Motors Corporation, Respondents.

"Count 1. In an internal combustion engine, means forming a mixing conduit, a throttle for controlling the mixture discharged from said conduit, a choke for controlling the admission of air to said conduit, means for partially closing said choke in response to an opening movement of said throttle when the temperature is low, thereby giving a richer mixture for acceleration, and heat responsive means for preventing such partial closing of the choke when the temperature is high.

"Count 2. In combination with an internal combustion engine having an intake manifold, a carburetor having a throttle and a choke valve, temperature responsive means influencing the movements of said valve and operative to move said valve toward open position when hot, and suction operated means capable of moving the valve to at least a

partially opened position, said suction operated means comprising a chamber having a fluid connection with the intake manifold at a point posterior to the throttle and having a movable spring pressed wall subject to the suction at said point, said choke valve being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction.

"Count 3. The combination with an internal combustion engine, a carburetor having a choke, temperature responsive means yieldingly urging the valve toward closed position, and suction operated means capable of moving the valve to at least a partially opened position when the temperature responsive means tends to hold the choke valve in closed position, said choke valve being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded regardless of suction.

"Count 4. In or for an internal-combustion engine having a control for varying the fuel mixture, the combination of a thermostatic bimetallic element having a part which is movable according to changes of engine temperature, linkage means connecting said movable part for coupling with the fuel mixture control, a pressure responsive device for operation according to pressure in the induction system of the engine and a lost motion connection operatively connected between said pressure-responsive device and said linkage means.

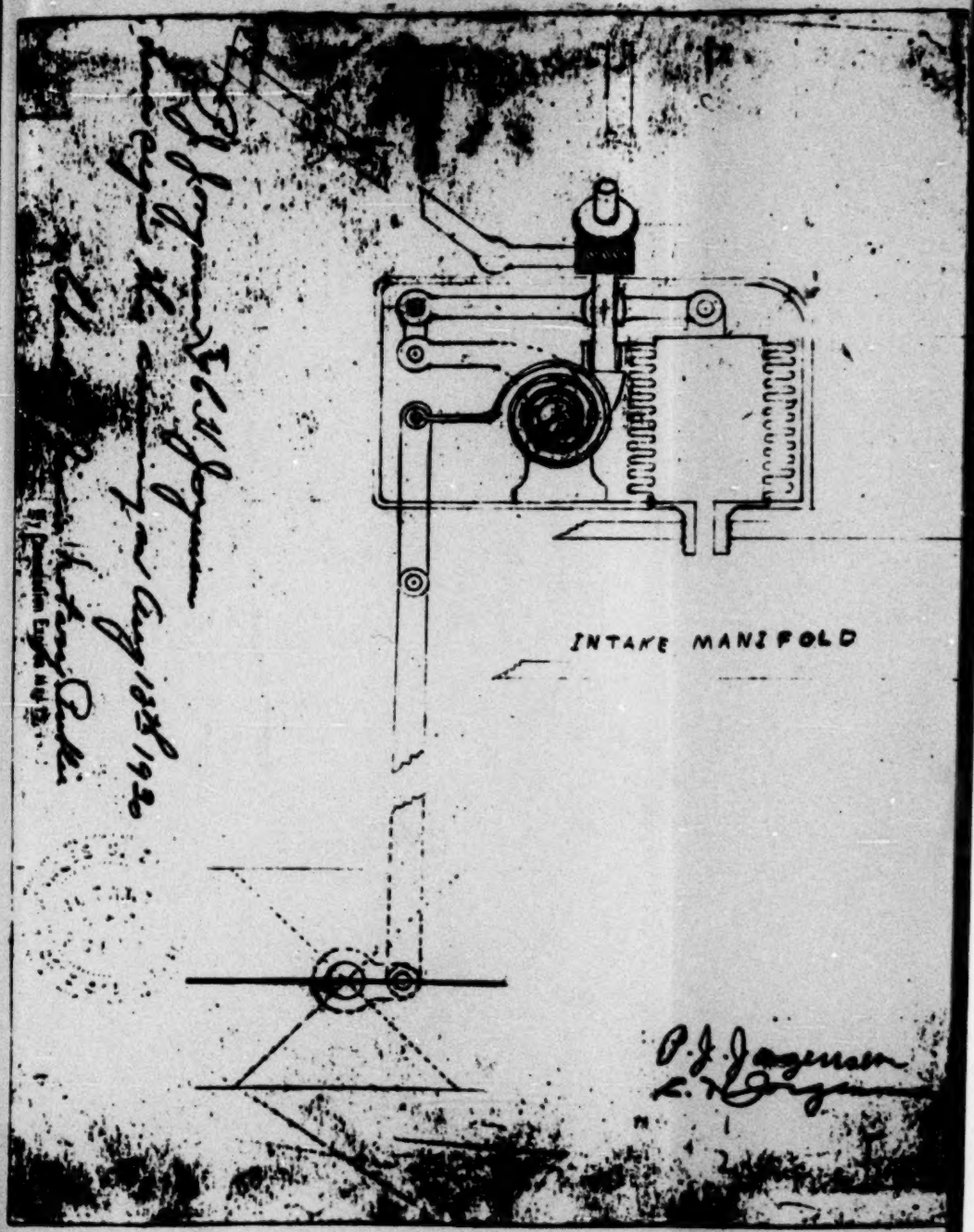
"Count 5. In combination with an internal combustion engine a carburetor having a choke valve, temperature responsive means yieldingly urging the choke valve toward closed position, and suction operated means capable of moving the valve to a partially opened position while said temperature responsive means urges the choke valve to-

ward closed position, said choke valve being moved to fully open position when the normal operating temperature is reached or exceeded and remaining in such fully open position as long as said normal operating temperature is maintained or exceeded, regardless of suction."

Count Involved in George R. Ericson and Carter Carburetor Corporation, Petitioners v. Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator of the Estate of Peter J. Jorgensen, Deceased, and General Motors Corporation, Respondents.

"Count 1. In a carburetor, means forming a mixing conduit, said conduit including a main air inlet, a main fuel inlet, and a mixture outlet, a manually operated throttle valve for said conduit, an inlet valve for controlling the flow through one of said inlets to enrich or lean out the fuel mixture discharged by said carburetor, a heat responsive device for controlling said valve in accordance with the temperature to lean out the mixture upon an increase of temperature, said heat responsive device being constructed and arranged to operate said valve only when the temperature is below normal, and means for operating said valve to lean out said mixture upon an increase in suction in the carburetor, said last-named means including a suction conduit connected to a point in the mixing conduit posterior to said manually operated valve, and means for temporarily enriching the mixture delivered by said carburetor upon an opening movement of said throttle, regardless of the position of said inlet valve."

Plaintiffs' Exhibit 22.



Decision of the Board of Interference Examiners in Jorgensen and Jorgensen v. Ericson.

Paper No. 84

Final Hearing
June 29, 1945

LFK/mit

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF INTERFERENCE EXAMINERS

Patent Interference No. 80,733

Jorgensen and Jorgensen v. Ericson

Carburetors

Application of Peter J. Jorgensen and Clarence H. Jorgensen, filed January 8, 1932, No. 585,510.

Application of George R. Ericson, filed December 30, 1940, No. 372,428, (Reissue) Original patent No. 1,915,851, patented June 27, 1933, on Ser. No. 573,418, filed November 6, 1931.

Messrs. Brown, Jackson, Boettcher & Dienner, and Mr. Craig V. Morton for Jorgensen and Jorgensen.

Mr. D. U. Rich and Mr. George R. Ericson for Ericson.

This interference relates to a device for automatically controlling the richness of the mixture discharged by the carburetor of an internal combustion engine in response to temperature and vacuum conditions of the engine.

The interference involves one count which is copied below:

> In a carburetor, means forming a mixing conduit, said conduit including a main air inlet, a main fuel

inlet, and a mixture outlet, a manually operated throttle valve for said conduit, an inlet valve for controlling the flow through one of said inlets to enrich or lean out the fuel mixture discharged by said carburetor, a heat responsive device for controlling said valve in accordance with the temperature to lean out the mixture upon an increase of temperature, said heat responsive device being constructed and arranged to operate said valve only when the temperature is below normal, and means for operating said valve to lean out said mixture upon an increase in suction in the carburetor, said last-named means including a suction conduit connected to a point in the mixing conduit posterior to said manually operated valve, and means for temporarily enriching the mixture delivered by said carburetor upon an opening movement of said throttle, regardless of the position of said inlet valve.

The junior parties, Jorgensen *et al.*, have the burden of proving priority of invention by a preponderance of the evidence.

Both parties took testimony, filed briefs and were represented at final hearing.

Jorgensen *et al.* are relying on several developments, in this and related interferences, for conception and reduction to practice. The first of these is a device which allegedly was constructed in accordance with Jorgensen *et al.* Exhibit 2, an undated and unsigned drawing, and installed on a Buick car in 1927. The original device according to Exhibit 2 could not be found, however, Exhibit 6 purports to be a substantial duplicate of the original device and was constructed for this interference from the drawing, Exhibit 2.

The witnesses Gray, Kyser and Mrs. Jorgensen testified concerning the installation and operation of the device on the Buick. However, neither Gray, who installed the device, nor Mrs. Jorgensen were familiar with the internal structure of the device, thus they are obviously in no posi-

tion to corroborate Jorgensen as to operation of a device corresponding to the count in issue whose structure could only be ascertained from an examination of the internal construction. (Fausek *et al.* v. Vincent, 488 O. G. 3, 1938 C. D. 184, 25 C. C. P. A. 770, 92 F. (2d) 909).

Kyser testified concerning the device, in part as follows:

> Q. 29. While you were associated with Mr. Jorgensen in developing this thermostat cooling system for use on the Studebaker, did Mr. Jorgensen discuss with you any other device on which he was working at that time?
>
> A. Yes, the automatic choke.
>
> Q. 30. What in general was the nature of this device; what was it supposed to do?
>
> A. It was supposed to eliminate the necessity of a manual choke. He had it installed on a Buick that he had at the time.
>
> Q. 31. Was this an automatic mechanism to control in some way the proportioning of the fuel and air in the mixture supply to the engine?
>
> A. Yes. The first device that I knew anything about was an auxiliary carburetor, or it had the effect of an auxiliary carburetor, that fed an additional amount of fuel into the manifold for cold starting.
>
> Q. 32. Did you discuss this device with Mr. Jorgensen in considerable detail?
>
> A. That is right.
>
> Q. 33. Did Mr. Jorgensen ever show you at any time a device such as you have just described?
>
> A. Yes.
>
> Q. 34. Which Mr. Jorgensen had built?
>
> A. That is right.

Without further describing the construction of the device Kyser was handed Exhibit 2 and asked if that was a drawing of the device which he had seen on Jorgensen's Buick to which he answered "It is very similar if not the

same." Then referring to the drawing he proceeded to describe the construction and operation of the device.

It is noted that the testimony of Kyser was given in 1943, some sixteen years after the events were alleged to have occurred, and is based purely on recollection without the benefit of any written documents made at the time or without the aid of the actual device which had been tested. Under these circumstances, the testimony must be very clear and convincing. (Schwartz v. Graenz 467 O. G. 473, 1936 C. D. 233, 23 C. C. P. A. 883, 81 F. (2d) 767).

As may be seen from the record, many of the answers of Kyser were given in response to leading questions, which of course does not affect their admissibility, but does greatly weaken their probative value. Attention is also directed to the fact that only a very sketchy description of the invention (quoted above) in no way satisfying the requirements of the count, was given by Kyser before he was handed the drawing Exhibit 2 or the device Exhibit 6.

In our opinion, the manner in which this testimony of Kyser was taken does not carry the conviction and certainty which is required of oral testimony after such a long lapse of time. In addition, it is considered significant that Kyser in a letter to Jorgensen written May 17, 1932 (Exhibit 36) concerning work on the automatic choke, gave only a very brief and incomplete description of the automatic choke which amounted to no more than that it operated on the fuel valve and was controlled by vacuum and thermostatic metal, saying,

> "* * * some of the early discussions between you and I (sic) are rather hazy in my mind. I have mentioned only things I definitely remember as can be recalled from these events that happened during this time."

The count is more limited than the broad idea of control by heat and suction as is obvious from a reading thereof.

For the above reasons, we consider Kyser's testimony inadequate to establish that the device which was tested on the Buick responded to the count in issue; thus Jorgensen *et al.* fail in presenting any satisfactory corroboration as to this device.

In addition to the above, there is not a single bit of evidence to show at what engine temperature the Buick was started or operated with Jorgensen's device thereon. It is true that there is testimony that the car was operated in the winter and at times when there was ice on the streets, but it does not appear whether the car was left in a heated garage or otherwise. We cannot infer from the fact that the car was operated in the wintertime that it was ever started from a sufficiently cold start that would constitute a fair indication of its usefulness.

Consequently, we believe Jorgensen *et al.* have failed to establish either a conception or reduction to practice of the invention in issue by means of the Buick device.

The next alleged development was the installation of an automatic control device used on the air valve of a Schebler carburetor on a Studebaker which was acquired for Jorgensen for experimental purposes from the Studebaker Company in 1928. Following this the same control device was applied to a Stromberg carburetor which had replaced the Schebler on the Studebaker. Tests on the Stromberg were allegedly made in the winter of 1929 and 30.

Mrs. Jorgensen and Kyser were the only corroborating witnesses as to these tests and the testimony of both of them is subject to the same weaknesses as were discussed in connection with the Buick tests. Mrs. Jorgensen obviously did not know anything of the mechanical details of the device and Kyser testified solely from memory of events long since past. He failed to give an adequate description of the structural details of the device until after he had been led by being shown the device and photographs thereof which would obviously have their effect in coloring his

testimony in respect thereto no matter how honest he may have been in attempting to give the facts as he remembered them.

It is true that Jorgensen testified that the control device which forms a part of Exhibit 13 was the one actually used on the Studebaker and counsel for Jorgensen asserts in his brief that Kyser corroborates Jorgensen as to the choke control unit being the original by stating that the unit of Exhibit 13 was also installed with the Schebler carburetor.

Kyser's testimony on this point is as follows:

> "Q. 105. Was the Jorgensen choke control unit device which is on Exhibit 13, which is the manifold we have here, on the Studebaker car with the Jorgensen choke control on the Schebler?
>
> A. Yes, sir."

While it may be that the device referred to was the original device the above testimony given as it was many years after the events and without reference to any identifying characteristics or without even asserting that it is in the same condition now as it was at the time it was allegedly used, falls far short of being persuasive that the device was the same device without material alteration.

The testimony relative to the tests leaves much to be desired. It is true that there is testimony to the effect that the operation of the various devices was satisfactory over relatively long periods of time, however, there is no affirmative testimony as to the engine temperatures at starting; nor is there any evidence as to fuel consumption which would indicate whether or not it was excessive in comparison to ordinary carburetors, then in use.

During the taking of testimony, the control device was used in connection with the Schebler carburetor at recorded temperatures of from 6° to 50° F. with apparently satisfactory results. Lacking adequate corroboration of reduction to practice, this cannot be used to establish that the use

fourteen years previously was a successful reduction to practice as it is well established that a device cannot be reduced to practice *nunc pro tunc* in this manner (Smith v. Warnock 287 O. G. 195, 1921 C. D. 186, 50 App. D. C. 326, 271 Fed. 556; Bainbridge v. Walton 509 O. G. 291, 1939 C. D. 803, 26 C. C. P. A. 1417, 104 F. (2d) 808).

The further fact that Jorgensen *et al.* waited until 1932 to file an application on an invention allegedly reduced to practice in 1927-29, when they were actively engaged in patent licensing, is persuasive that the tests were not considered satisfactory.

Even if it be conceded that Kyser's testimony is adequate to establish that devices in accordance with the count were installed it is noted that Kyser does not testify that he actually saw any movement of the control elements of any of the Buick or Studebaker devices in response to either temperature or suction. Thus there is no direct testimony that the devices operated in the manner set forth in the count. That the devices did operate in response to temperature and suction can only be inferred from Kyser's testimony that they operated satisfactorily. Thus it is obvious that the testimony of Kyser when viewed in the light most favorable to Jorgensen establishes only that devices responding to the count in issue were installed and the cars operated in a satisfactory manner without indicating in any way that this satisfactory operation was a result of, or dependent upon, the devices so installed. For all that appears in the testimony of Kyser, the cars may have operated just as well without the alleged improvements as with them. (Triplett v. Steinmayer, 545 O. G. 229, 1942 C. D. 687, 29 C. C. P. A. 1243, 129 Fed. 869, 54 P. Q. 409).

We are thus compelled to the conclusion that Jorgensen *et al.* have not established a reduction to practice by satisfactorily corroborated evidence prior to the filing date of the Ericson application.

Even if Jorgensen *et al.* were accorded a conception of the invention in issue as a result of the work on the

Buick or the Studebaker, there is no convincing evidence that they were exercising reasonable diligence in reducing to practice beginning just before Ericson's proved entry into the field in the fall of 1929.

Aside from the considerations above, Ericson has attacked the device used on the Buick as not satisfying the count in issue.

We believe it unnecessary to consider the applicability of the Buick device to the count as the character of the testimony with respect to the Studebaker device is just as strong as that with regard to the Buick device as far as conception and reduction to practice is concerned, thus Jorgensen *et al.* will stand or fall on the Studebaker devices which appear to support the count.

During the motion period Ericson moved to dissolve the interference on the grounds that Jorgensen *et al.* (1) did not disclose the subject matter of the count and (2) estoppel. It is contended by Ericson that the kicker 55 of Jorgensen *et al.* may move to flex the thermostat K when the engine is at or above normal temperature causing the thermostat to reopen the choke, thus not satisfying the requirement of the count that the thermostat is "arranged to operate said valve only when the temperature is below normal".

The operation of the choke as set forth above is the result of a change in condition in the kicker rather than in response to the temperature of the thermostat, thus we believe it proper to say that the choke is not operated by the thermostat when the temperature is above normal; hence we deem that Jorgensen *et al.* disclose this feature of the count.

It is also urged that Jorgensen *et al.* do not disclose "means for temporarily enriching the mixture delivered by said carburetor upon an opening movement of said throttle, regardless of the position of said inlet valve."

We agree with the position of the primary examiner that as long as the engine is running or being cranked the valve 14 will not be completely closed, thus the kicker will

partly close the valve 14 regardless of its position thereby satisfying the requirement of this portion of the count.

The estoppel contention has not been urged before us; however, we find no error in the decision of the primary examiner on this point.

In view of the position we have taken relative to the proofs of Jorgensen *et al.*, the question of Ericson's dates is of no substantial importance. However, we believe that his record adequately establishes conception of the invention in issue not later than the fall of 1929, but no reduction to practice prior to his filing date.

Jorgensen *et al.* have raised the point that the primary examiner refused to add certain counts to the interference and asks that this be considered if this be permissible under the provisions of Rule 130. This is a matter which cannot be considered by this Board as it does not relate to the issue of priority of invention (See Josserand v. Taylor, Jr., 557 O. G. 217, 1943 C. D. 710, 31 C. C. P. A. 709, 138 F. (2d) 58).

Priority of invention of the subject matter in issue is hereby awarded to George R. Ericson, the senior party.

W. E. Waite
Examiner of Interferences
A. Y. Casanova, Jr.
Examiner of Interferences
Louis F. Kreek
Examiner of Interferences
Board of Interference
Examiners

October 31, 1945

Decision of the Board of Interference Examiners in Jorgensen et al. v. Ericson on Petition for Reconsideration.

LFK/mit

Paper No. 86.

224-A

Address only "The Commissioner of Patents," and not any official by name

All communications respecting this application should give the serial number, date of filing, title of invention, and name of the applicant

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
Washington 25, D. C.

Please find below a communication from the EXAMINER OF INTERFERENCE in this case.

CASPER W. OOMS,
Commissioner of Patents.

Craig V. Morton
400 Linden Ave.
Dayton, Ohio

Interference No. 80,733
Jorgensen et al.
v.
Ericson

DECISION ON PETITION FOR RECONSIDERATION

The party Jorgensen *et al.* has filed a petition for reconsideration of our decision of October 31, 1945, awarding priority of invention to the senior party, Ericson.

A number of points have been raised, some of which are merely an elaboration of the arguments presented in the brief at final hearing. We have carefully considered all of the arguments, however, no attempt will be made to discuss each of them at this time.

It is argued that the testimony of Gray, Kyser and Mrs. Jorgensen establishes a reduction to practice of the invention in issue as a result of successful use on the Buick.

All that the testimony of Gray and Mrs. Jorgensen,

standing alone, tends to establish is that the car operated in a satisfactory manner with some kind of an automatic choke. They were in no position to corroborate Jorgensen that the device corresponded to the counts in issue. It is attempted to establish by Kyser's testimony that the device in the Buick responded to the counts in issue and to thereby connect the testimony of Gray and Mrs. Jorgensen with a device corresponding to the issue.

The difficulty with this position is that even if Kyser's testimony were adequate to establish the character of the device which he saw on the Buick, it would not be sufficient to prove that it remained on continuously, or was in use at the times when Gray and Mrs. Jorgensen operated the car, as the record does not show that Kyser saw the device after the football game except on those occasions on which Jorgensen drove the car from Chicago to South Bend. It is too much to presume that the device was actually on the car and in use at all times between these visits.

Furthermore, we have held that Kyser's testimony is insufficient to establish that the device on the Buick responds to the counts in issue. In doing so we had no intention of and did not impugn the honesty of Kyser. Our conclusion was merely based on the well recognized fact, as pointed out in the case of Schwartz v. Graenz cited in our decision, that human beings are apt to forget details after the lapse of many years.

As to our comments on the leading character of the examination, counsel argues that our position was in error and that the answers must be taken at face value as no objection was interposed by opposing counsel during the examination. We cannot agree with this position. In the case of Chandler v. Mock, 580 O. G. 159, 150 F. (2d) 563, 66 U. S. P. Q. 209, — C. C. P. A. —, the court commented on the value of evidence given after a long lapse of time in response to leading questions. It is noted in that case opposing counsel was present at the taking of testimony but no objections were interposed as to the leading character of the questions during the examination.

We did not conclude nor state that Kyser did not know what was on the Buick until he was shown the drawing, the only thing we concluded in this respect was that the character of the examination was such that we had no reasonable way of ascertaining just what he did know from his unaided recollection.

Kyser never testified that he had ever seen the drawing, Exhibit 2, at any time prior to the taking of testimony thus as far as his corroborating testimony is concerned, it was given without the aid of any written document with which he was familiar which was contemporaneous with the Buick tests.

The same weaknesses exist as to the testimony relating to the Studebaker device as are present in the Buick device.

As to Jorgensen's diligence in reducing to practice, conceding, *arguendo* that conception had been established, it is to be noted that corroborated evidence is required showing diligence in reducing to practice beginning just prior to his opponent's entry into the field and extending to Jorgensen *et al.*'s established reduction to practice.

Kyser testified concerning tests on the Stromberg carburetor during the winter of 1929-30 but he did not know how long this equipment was in use.

Mrs. Jorgensen did not know how long Jorgensen had the Studebaker.

From this testimony, we concluded that Jorgensen *et al.* had not produced satisfactorily corroborated testimony that they were diligent in reducing to practice.

The petition for reconsideration is granted, however, our decision of October 31, 1945, is adhered to.

W. E. Waite
Examiner of Interferences
A. Y. Casanova, Jr.
Examiner of Interferences
Louis F. Kreek
Examiner of Interferences
Board of Interference
Examiners

Decision of the Board of Interference Examiners in Jorgensen and Jorgensen v. Henning.

Paper No. 152

Final Hearing
June 29, 1945

LFK/ES

IN THE UNITED STATES PATENT OFFICE
BEFORE THE BOARD OF INTERFERENCE EXAMINERS

Patent Interference No. 78,345

Jorgensen and Jorgensen v. Henning

Carburetors

Application of Peter J. Jorgensen (deceased) and Clarence H. Jorgensen filed January 8, 1932, No. 585,510.
Application of Otto Henning filed November 17, 1931, No. 575,577.

Messrs. Brown, Jackson, Boettcher & Dienner and Mr. Craig V. Morton for Jorgensen and Jorgensen.
Mr. Donald U. Rich and Mr. George R. Ericson for Henning.

This interference relates to a device for automatically controlling the richness of the mixture discharged by the carburetor of an internal combustion engine in response to temperature and vacuum conditions of the engine.

The interference involves five counts of which count 4, copied below, is considered illustrative.

> *Count 4.* In or for an internal-combustion engine having a control for varying the fuel mixture, the combination of a thermostatic bimetallic element having a part which is movable according to changes of engine temperature, linkage means connecting said movable

part for coupling with the fuel mixture control, a pressure-responsive device for operation according to pressure in the induction system of the engine and a lost motion connection operatively connected between said pressure-responsive device and said linkage means.

The junior parties Jorgensen *et al.* have the burden of proving priority of invention by a preponderance of the evidence.

Only Jorgensen *et al.* took testimony; however, both parties filed briefs and were represented at final hearing.

For failure to take testimony the party Henning is restricted to his filing date of November 17, 1931 for conception and reduction to practice.

For reasons more fully set forth in companion interference No. 80,733 involving Jorgensen *et al.* and Ericson, who has a common assignee with Henning, we are of the opinion that Jorgensen *et al.* have neither established conception, nor reduction to practice of any of the devices relied upon prior to Henning's filing date, nor diligence in reducing to practice during the critical period.

Priority of invention of the subject matter in issue is hereby awarded to Otto Henning, the senior party.

W. E. Waite
Examiner of Interferences
A. Y. Casanova, Jr.
Examiner of Interferences
Louis F. Kreek
Examiner of Interferences
Board of Interference Examiners

October 31, 1945

Decision of the Board of Interference Examiners on Petition for Reconsideration in Jorgensen, et al. v. Henning.

LFK/mit

Paper No. 154

224-A

Address only "The Commissioner of Patents," and not any official by name

All communications respecting this application should give the serial number, date of filing, title of invention, and name of the applicant

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
Washington 25, D. C.

Please find below a communication from the EXAMINER OF INTERFERENCE in this case.

CASPER W. OOMS,
Commissioner of Patents.

Mr. Craig V. Morton
Patent Dept.
Delco Products Div.
General Motors Corp.
Dayton, Ohio

Interference No. 78,345
Jorgensen et al.
v.
Henning

DECISION ON PETITION FOR RECONSIDERATION

The party Jorgensen *et al.* has filed a petition for reconsideration of our decision of October 31, 1945, awarding priority of invention to the senior party, Henning.

For reasons more fully set forth in our decision on reconsideration in Interference No. 80,733, we adhere to our decision of October 31, 1945.

W. E. Waite
Examiner of Interferences
A. Y. Casanova, Jr.
Examiner of Interferences
Louis F. Kreek
Examiner of Interferences
Board of Interference Examiners

Opinion of the District Court in Clarence H. Jorgensen, et al. v. George R. Ericson, et al.

[fol. 35] (Memorandum Opinion in Case No. 4545.)

In the United States District Court for the Eastern District of Missouri, Eastern Division.

Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator, and General Motors Corporation, Plaintiffs,

vs.

George R. Ericson and Carter Carburetor Corporation, Defendants.

No. 4545

This is a suit brought under Title 35, Section 63, U. S. C. A. (Revised Statutes, Sec. 4915) to authorize the Commissioner of Patents to issue a patent embodied in claims which were the subject matter of an interference proceeding before the Patent Office to the General Motors Corporation, assignee of plaintiffs Clarence H. Jorgensen and Clarence H. Jorgensen, Administrator, pursuant to application No. 585,510, filed January 8, 1932.

The application refers to an automatic choke to regulate and control the flow of fuel and air into the carburetor of an automobile to facilitate the starting thereof in cold weather. As the common subject matter of the claims embodied in the interference proceedings were determined by the Patent Office, I see no reason for a more detailed description of the patents or claims in controversy.

Upon an adverse decision by the Board of Interference Examiners in the interference proceedings, the plaintiffs brought separate actions against George Ericson and Otto Henning, and by agreement the two suits were consolidated for purpose of trial, but this memorandum opinion deals

only with the Ericson case. A separate opinion will be filed in the Henning case. The ultimate question for determination is one of priority—that is, who got there the "fustest with the mostest". To sustain their contention of priority, the plaintiffs introduced in evidence part, but not [fol. 36] all, of the evidence presented to the Patent Office Tribunal in the form of depositions and exhibits, and also, in addition thereto, offered witnesses who had not testified before the Patent Office Tribunal.

A motion to dismiss was filed by defendants, prior to the introduction of evidence, attacking the jurisdiction of the court, and the motion was taken under consideration for determination with the cases.

Defendants insist that as the plaintiffs' original complaint did not state a cause of action and the amendment made on the day the trial began, being more than six months after the decision of the Board of Interference Examiners, did not date back to the filing of the original complaint and that their suits are barred by the Statute of Limitations. The plaintiffs' original complaint alleged in part:

> "1. This action arises under United States Code, Title 35, Sec. 63, (Revised Statutes, Sec. 4915) as amended March 2, 1927, (44 Stat. 1336) and March 2, 1929 (45 Stat. 1476). • • •
>
> "After due proceedings had, the Board of Interference Examiners in the Patent Office, on the 31st day of October, 1945, awarded priority of invention of all of the aforesaid counts to Otto Henning. Upon presentation of a Petition for Reconsideration, the Board of Interference Examiners refused to change its award of priority of invention and on December 26, 1945, denied said Petition. The Commissioner of Patents has refused to grant a patent to Plaintiff, General Motors Corporation, for the subject matter of said interference."

On the day of the trial, after objections had been made by defendants to the complaint, by leave of court, plaintiffs amended their complaint by adding the following language:

"1. By adding to paragraph 1, page 1, of said Complaint, the following:

'and as amended August 5, 1939 (53 Stat. 1212)'

"2. By adding to paragraph 10, page 5, after the word 'Interference' the following:

'in view of said decisions. In these premises the plaintiffs, Clarence H. Jorgensen (also Administrator) and General Motors Corporation, affirm themselves to be dissatisfied with the decisions of the Board of Interference Examiners.'"

[fol. 37] Defendants insist that no such statute existed as alleged in the complaint; that the statute referred to had been repealed, was non-existant and that no cause of action could be based upon it; and that plaintiffs did not allege in their original complaint that they were dissatisfied with the decision of the Board of Interference Examiners; and that inasmuch as the statute provides that when the losing party is dissatisfied with the decision of the Board of Interference Examiners, he may bring a suit in the District Court to authorize the Commissioner of Patents to issue a patent, the use of such language in a complaint is jurisdictional and the failure to do so deprives the court of jurisdiction. They further contend that an amendment adding such language made more than six months after the decision of the Board would not cure the original defect.

Before proceeding to a discussion of the facts and other legal questions raised by the defendants, the jurisdictional question should be determined. The section of the statute authorizing these suits, Title 35, Section 63, U. S. C. A., was first passed in 1870 (16 Stat. 205, Sec. 52). It was amended in 1927, again in 1929 and finally in 1939. Of course, the

defendants are right in their contention that in 1947, when this suit was brought, there was no such law as that enacted by the amendment of 1929 because another amendment had been made in 1939, and Title 35, Section 63, U. S. C. A., as changed by the 1939 amendment was then the law. After the 1939 amendment became effective there was no reason to refer to the amendments of 1927 and 1929 when pleading the statute, in seeking to apply its provisions to acts occurring subsequent to its effective date. It seems to me that it was entirely unnecessary for the pleader, in referring to Title 35, Section 63, U. S. C. A., (Rev. Stat. 4915), to add the explanatory words as to when the act had been amended. Such language was simply surplusage. It was not even necessary to confer jurisdiction on the court to mention the section of the statute under which it was brought. If the allegations of fact in a complaint show jurisdiction in the court, nothing else is necessary. Should a pleader merely mention the statute as a basis for establishing [fol. 38] jurisdiction and make no other allegations of fact applicable thereto, then he might be bound by such reference; but that is not the case here. A reading of the pleading clearly shows jurisdiction of the subject matter of the suit in the District Court.

Next we come to the question of whether it was necessary for the pleader to quote the words of the statute providing when suit may be brought by an applicant who had been denied a patent. Section 63 (supra) provides that:

> "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant * * * may have remedy by bill of equity, * * *"

Defendants cite no authority to sustain their contention. I do not believe it was necessary to quote the language of the statute in the complaint. The words are simply explanatory of the conditions which authorize the losing party

to institute a suit in the District Court and are not jurisdictional. No particular words are necessary if the general allegations show that the Board of Interference Examiners has decided against him—that is, the allegation that the Commissioner of Patents (the only one who could grant a patent) had refused to do so would be sufficient. Under such circumstances the bringing of the action would clearly express dissatisfaction with the action of the Board of Interference Examiners. I think the allegations of the original complaint clearly stated a cause of action, the jurisdiction of which was in the District Court. The amendment was unnecessary, but having been made, it simply stated more clearly and spelled out in greater detail that which was already sufficient. In view of the foregoing the motion of the defendants to dismiss for lack of jurisdiction is overruled.

The defendants next contend that:

> "Findings of the Patent Office Tribunal may not be set aside in these actions, in that not all the evidence on which they were made were presented to this court."

As heretofore stated, plaintiffs did not introduce all of the evidence which had been submitted to the Patent [fol. 39] Office Tribunal. Defendants cite many cases to sustain their position, but with few exceptions they are cases where the court was reviewing the action of some governmental agency rather than trying the case de novo as we are here. It seems to me almost inconceivable that in view of the wording of the statute this court cannot proceed to a determination of the suit upon such evidence as is submitted to it, either all or any part of that which was before the Patent Office Tribunal. The statute is clear and unambiguous. It provides:

> "In all suits brought here under where there are adverse parties the record in the Patent Office shall be admitted *in whole or in part*, on motion of either party,

subject to such conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, *or parts thereof*, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit." (Emphasis supplied.)

The language concerning the introduction of the testimony and exhibits before the Patent Office first appeared in the 1927 amendment. Prior to that amendment the statute was silent as to procedure before the District Court. Clearly, it was the intent of Congress that the parties might introduce the whole or any part of the evidence heard by the Patent Office Tribunal for consideration and it is to be given *"the same force and effect as if originally taken and produced in the suit."* (Chapter 273, Sec. 11, 44 Stat. 1336, March 2, 1927).

Next should be considered defendants' contention that:

> "In a suit under R. S. 4915, parties may not introduce new evidence without showing that the evidence was not available for presentation to the Patent Office Tribunal."

At the trial of this suit, plaintiffs introduced the testimony of Mrs. Jorgensen, Howard N. Kyser, and Craig V. Morton, who testified to certain facts concerning the construction and use of the device in controversy. Their testimony was not before the Patent Office Tribunal. It is their testimony to which the defendants object. Defendants cite a number of decisions to sustain their contention and while there may be some [comflict] of authorities, again, the statute seems to be perfectly clear. The right is given [fol. 40] to the parties *"to take further testimony"*. Apparently, where the courts have excluded "further testimony" there has been some special reason for doing so as in Barrett Co. et al. v. Koppers Co. et al. (22 Fed. 2nd 395), where the withholding of evidence before the Patent

Office was willful. In the Barrett case the witness refused to answer questions before the Board of Interference Examiners and later testified in court to the same facts concerning which he had refused to testify before the Tribunal. There is no evidence here of withholding or concealing the testimony of the witness from the Board. Plaintiffs' application had rested in the Patent Office without action from 1932 until 1945, 13 years before the interference was declared, and then in connection with the renewal of the Ericson patent. The development of the device and its alleged reduction to practice occurred in 1928 and 1929.

The witnesses *were available* and their testimony *could have been obtained* for submission to the Board; but there is no substantial suggestion that their testimony was concealed or deliberately withheld. The war was on and those engaged in mechanical production were busy. Plaintiff testified, and it was undisputed, that he had not talked to these witnesses, except to his wife, for many years prior to the hearing. This contention is ruled against defendants.

Next we come to the final and more difficult question: were plaintiffs the first to conceive and reduce to practice the device which is the subject matter of the Interference and of this suit? The Board of Interference Examiners found that plaintiffs' evidence with respect thereto was not corroborated and therefore decided against him. We are not hearing this suit on appeal or simply reviewing the record of the Patent Office for errors. We are trying it de novo and the court must make its findings and come to its conclusions from the evidence introduced in this suit and decide it as *"the facts in the case may appear'*. In reaching a decision, the court must keep in mind the principle laid down in Morgan v. Daniels, 153 U. S. 120, that the decision of the Patent Office is [fol. 41] controlling upon questions of fact unless the contrary is established by testimony which in character and amount carries thorough conviction. That case was decided long before the amendment which authorized the introduction of the whole or any part of the evidence

before the Board and which authorized the introduction of other evidence before the court. This principle is still recognized by the courts. Minnesota Mining and Mfg. Co. et al., v. Carborundum Co. et al., 155 Fed. (2) 746. So this court must review the weight of the evidence before it, keeping in mind the presumption of correctness of the Board's ruling and that the burden is upon the plaintiffs to show by strong, cogent and convincing evidence sufficient to carry thorough conviction that they are entitled to priority. The doctrine requires more convincing proof than in the ordinary case, not beyond a reasonable doubt but certainly more than the mere burden of proof. I am not quarreling with the doctrine; but in arriving at its findings and conclusions, having in mind the doctrine aforesaid, the court will apply its own rules for the consideration of evidence and not rules which apparently are followed by the Patent Office, particularly with respect to corroboration. I know of no rule of law which requires the court to require corroboration where the evidence is otherwise sufficiently convincing whatever the degree of proof may be. In other words, it is not necessarily the greater number of witnesses testifying, but such evidence as is more satisfying and convincing to the court whether it be one or a dozen witnesses. It is not, of course, an uncommon thing in a trial of a case before a jury or the court for one or two witnesses to be far more convincing than the testimony of a dozen witnesses on the other side. After all, the final decision of the court, its findings and conclusions, are *its* findings and conclusions and the decision is based upon the evidence before it. If, upon a consideration of the evidence before it, that which was before the Board and new and additional evidence, the court is thoroughly convinced that the plaintiff was the first to conceive and reduce to practice the patent, then its decision should be for the plaintiffs. If such evidence [fol. 42] is not so convincing, then, of course, its findings and conclusions and its decision should be for the defendants regardless of

what the Patent Office Tribunal may have done. As I understand the rule, the only distinction between this and any other case is that of the burden of proof. In this case a higher degree of proof is required than in the usual case. So, bearing in mind throughout this burden of proof of thorough conviction, we may forget the findings and conclusions of the Patent Office Tribunal and ask the question of ourselves: does the evidence before us carry thorough conviction?

The defendants insist that if there is any rational basis for the Board's findings they cannot be disturbed by this court. If that contention is true, then this court could not consider anything except the evidence before the Board. This suit would be in the nature of an appeal for a review of the record of the Patent Office Tribunal and not a trial de novo. The statute would be meaningless. The question of whether it is a trial de novo and of whether additional evidence may be received and the matter decided by the court upon the evidence before it has been decided in this circuit in Larson v. Crowther, 26 Fed. (2) 780, CCA 8, affirming Judge John B. Sanborn while he was a District Judge for the District of Minnesota. The case was decided before the 1927 amendment. On page 783 the court said:

> "The right exists in Crowther, notwithstanding that decision, to have determined on competent evidence in an equity proceeding in a Federal Court the question of whether his application for patents should have been allowed."
>
> (See also: International Standard Electric Corp. v. Kinsland, Comm'r of Patents, 169 Fed. (2) 890; Minnesota Mining and Mfg. Co. et al. v. Carborundum Co. et al. (supra).)

This disposes of the questions of law raised by the parties and brings us to a consideration of the evidence and the facts the evidence discloses.

The defendants Ericson and Henning and the plaintiffs Jorgensens all filed their applications for patents within

a comparatively short period of each other. Ericson's [fol. 43] application No. 573,418, was filed on November 6, 1931; Henning's application No. 575,577 was filed on November 17, 1931; and Jorgensen's application No. 585,510 was filed on January 8, 1932.

The application of Ericson No. 573,418 filed November 6, 1931, was acted upon and Patent No. 1,872,708 issued on August 23, 1932, and Patent Re. No. 22,742 issued April 9, 1946, upon application No. 372,428 for reissue. The application of Henning, No. 575,577, filed on November 17, 1931, was acted upon and Patent No. 2,421,733 was issued thereon on June 3, 1947, after the filing of this suit. The application of the plaintiff Jorgensen was not acted upon by the Patent Office until the question of reissue of defendant Ericson's patent came up although Jorgensen's application was filed on January 8, 1932. At the time of Ericson's application for a reissue an interference was declared by the Patent Office, Interference No. 78,345 with respect to the Henning patent, and Interference No. 80,733 with respect to the Ericson patent.

The Board of Interference awarded priority to Ericson and Henning on October 31, 1945, and upon a reconsideration adhered to their original finding.

Plaintiff Clarence H. Jorgensen and his father, who died in 1933, were engaged for many years in mechanical promotional work largely in the automotive field. They had been engaged in the manufacture of gasoline engines, both stationary and automotive. They had designed a carburetor but had not manufactured it. For many years (as is well remembered by all of us who lived before the modern automotive age) cars were equipped with manually operated chokes. As early as 1913 or 1914 the Jorgensens had designed a primer pump for injecting gasoline into the intake manifold of an engine as a starting device. This was represented by Patent No. 1,457,033, filed January 7, 1921. They continued to experiment with this type of device and particularly with the idea of an automatic choke

device. In 1926 patent No. 1,745,622 was [fol. 44] filed for a device to control the water temperature in an automobile engine. Many years—17 or 18—had elapsed between the beginning of experiments and the trial of these suits, and the time when certain events were alleged to have taken place was fixed by the happening of certain other events in relation thereto.

Plaintiff's testimony, if taken as true, tends to show that their device was tried out on a Buick automobile in 1927. He fixes the time by the birth of his twin sons on November 15, 1927, (an event not likely to be forgotten by any father) and by his attendance with one of the other witnesses at the Notre Dame-Southern California football gave on November 26, 1927. His device was a primer and provided an automatic device for supplying a rich mixture direct to the intake manifold upon starting, the rich mixture being cut off after the engine had started and had reached operating temperature. Plaintiffs say this device was in operation from October 1927 until August 1928. At that time the Buick car to which the device was attached was sold and the device removed. The evidence tends to show that the device operated satisfactorily in cold weather during that period. This fact is testified to by plaintiff, by Mr. Kyser who operated the car and saw it in operation, and by Morris Gray, a mechanic, who installed it on the Buick. This device was lost after its removal from the Buick and could not be produced either at the interference hearing or at the trial of this suit. In view of later developments I think we may forget this device except as it indicates the theory of the device which the plaintiffs were attempting to develop.

Following the disposition of the Buick car in August 1928, the Jorgensens acquired a Studebaker on October 20, 1928. Kyser and Clyde R. Paton who were connected with the Studebaker Company were instrumental in obtaining the Studebaker for the Jorgenses at wholesale price. Almost immediately after receiving the Studebaker, Jorgensen installed the choke control mechanism on it. All

of the witnesses, Jorgensen, Paton, Kyser and [fol. 45] Gilbert D. Williams, testified that the device worked satisfactorily. Paton and Kyser were automobile engineers, and Williams was an experienced automobile mechanic. At the time these tests were made, the Studebaker was equipped with a Schebler carburetor. Later, when the 1929 model Studebaker came out they were equipped with Stromberg carburetors and the Jorgensen car was then equipped with such a carburetor and their device attached to it. Improvements had been made in the meantime. The device remained on the car until July 1930 when the Jorgensens no longer had possession of the car at which time the device was removed. The witnesses whose names have heretofore been mentioned all followed the operation of the device and testified to its effectiveness. Nothing seems to have been done with the device between July 1930 and the time of filing the application for a patent in January 1932. Jorgensen became interested in other developments and plaintiff says that the automotive industry was not yet ready for such a device. That does not quite explain why an application for a patent was not filed, particularly when the developers of the device were engaged in mechanical development and were experienced in that field. The device used upon the Studebaker was demonstrated in December 1943 in the presence of the parties to this suit in temperatures of 22°F and proved to be satisfactory.

Defendant does not contend that his patent was reduced to practice prior to the filing of his application. The Patent Office Tribunal gives to Ericson the fall of 1929 as the earliest date of conception. That is unimportant as there was no reduction to practice by Ericson. Defendant has no evidence to disprove the evidence of the plaintiffs except that time must have dimmed the memory of the witnesses and that their testimony should not be believed, and that it falls short of being convincing in that degree required by the law.

As heretofore stated, all of the witnesses were engaged in the automobile industry and interested in its develop-

ment. They were men of experience in their field and [fol. 46] their integrity is unquestioned except to the extent that their memories could not be expected to retain the facts so long a time. While the demonstration before the Patent Office hearing of itself may not be conclusive as to the success and reduction to practice of the device in 1928 or 1929, certainly it is strong and persuasive evidence of its effectiveness while it was being tested in 1928 and 1929. This evidence, connected with the other evidence as to its use, is convincing.

Defendant contends that taking plaintiffs' evidence as true it still does not meet the requirements of the law. With this contention I cannot agree. A careful weighing of all the evidence which was presented to the Board of Interference Examiners and which has been submitted to this court carries that thorough conviction which is required by the law, that is, that plaintiffs conceived and reduced to practice their patent in 1928 and 1929 prior to the filing of defendant's application. As heretofore suggested, plaintiffs' reason for not having filed their application for a patent until 1932 seems to the court to be without merit. Plaintiffs having reduced their patent to practice laid it aside and did nothing further about it until after the filing of defendant's application. Were it not for the fact that under the law the plaintiffs once having reduced their patent to practicable application are not required to be diligent in filing an application, I should not hesitate to hold that the plaintiffs were lacking in diligence in the filing of their application; but that seems to make no difference and the court bows to superior judicial authority.

The Commissioner of Patents, so far as the question of priority is concerned, should be authorized to issue a patent upon plaintiffs' application. It Is So Ordered.

The parties may submit findings of fact and conclusions of law in accordance herewith.

R. M. Duncan,
District Judge.

Dated this 30th day of November, 1948.

Amended Opinion of the District Court in Clarence H. Jorgensen, et al. v. George R. Ericson, et al.

[fol. 94] Amended Memorandum Opinion.

Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator, and General Motors Corporation,

Plaintiffs,

vs.

George R. Ericson and Carter Carburetor Corporation,

Defendants.

No. 4545

It appearing to the court that certain errors in the court's finding in the quotation of evidence and other factual information were made in the memorandum opinion filed on the 1st day of December 1948, said memorandum opinion is hereby set aside and the following amended memorandum opinion conforming to the facts as heretofore called to the attention of the court is filed:

This is a suit brought under Title 35, Section 63, U. S. C. A. (Revised Statutes, Sec. 4915) to authorize the Commissioner of Patents to issue a patent embodied in claims which were the subject matter of an interference proceeding before the Patent Office to the General Motors Corporation, assignee of plaintiffs Clarence H. Jorgensen and Clarence H. Jorgensen, Administrator, pursuant to application No. 585,510, filed January 8, 1932.

The application refers to an automatic choke to regulate and control the flow of fuel and air into the carburetor of an automobile to facilitate the starting thereof in cold weather. As the common subject matter of the claims embodied in the interference proceedings were determined by the Patent Office, I see no reason for a more detailed description of the patents or claims in controversy.

Upon an adverse decision by the Board of Interference Examiners in the interference proceedings, the plaintiffs brought separate actions against George Ericson and Otto Henning, and by agreement the two suits were consolidated for purpose of trial, but this memorandum opinion deals only with the Ericson case. A separate opinion will be filed in the Henning case. The ultimate question for determination is one of priority—that is, who got there the "fustest with the mostest." To sustain their contention of priority, the plaintiffs introduced in evidence, part, but not [fol. 95] all of the evidence presented to the Patent Office Tribunal in the form of depositions and exhibits, and also, in addition thereto, offered witnesses who had not testified before the Patent Office Tribunal.

A motion to dismiss was filed by defendants, prior to the introduction of evidence, attacking the jurisdiction of the court, and the motion was taken under consideration for determination with the cases.

Defendants insist that as the plaintiffs' original complaint did not state a cause of action and the amendment made on the day the trial began, being more than six months after the decision of the Board of Interference Examiners, did not date back to the filing of the original complaint and that their suits are barred by the Statute of Limitations. The plaintiffs' original complaint alleged in part:

> "1. This action arises under United States Code, Title 35, Sec. 63 (Revised Statutes, Sec. 4915) as amended March 2, 1927, (44 Stat. 1336) and March 2, 1929 (45 Stat. 1476). * * *
>
> "After due proceedings had, the Board of Interference Examiners in the Patent Office, on the 31st day of October, 1945, awarded priority of invention of all of the aforesaid counts to Otto Henning. Upon presentation of a Petition for Reconsideration, the Board of Interference Examiners refused to change its award of priority of invention and on December 26,

1945, denied said Petition. The Commissioner of Patents has refused to grant a patent to Plaintiff, General Motors Corporation, for the subject matter of said interference."

On the day of the trial, after objections had been made by defendants to the complaint, by leave of court, plaintiffs amended their complaint by adding the following language:

"1. By adding to paragraph 1, page 1 of said Complaint, the following:

'and as amended August 5, 1939 (53 Stat. 1212)'

"2. By adding to paragraph 10, page 5, after the word 'interference' the following:

'in view of said decisions. In these premises, the plaintiffs, Clarence H. Jorgensen (also Administrator) and General Motors Corporation, affirm themselves to be dissatisfied with the decisions of the Board of Interference Examiners."

[fol. 96] Defendants insist that no such statute existed as alleged in the complaint; that the statute referred to had been repealed, was non-existent and that no cause of action could be based upon it; and that plaintiffs did not allege in their original complaint that they were dissatisfied with the decision of the Board of Interference Examiners; and that inasmuch as the statute provides that when the losing party is dissatisfied with the decision of the Board of Interference Examiners, he may bring a suit in the District Court to authorize the Commissioner of Patents to issue a patent, the use of such language in a complaint is jurisdictional and the failure to do so deprives the court of jurisdiction. They further contend that an amendment adding such language made more than six months after the decision of the Board would not cure the original defect.

Before proceeding to a discussion of the facts and other legal questions raised by the defendants, the juris-

dictional question should be determined. The section of the statute authorizing these suits, Title 35, Section 63, U. S. C. A., was first passed in 1870 (16 Stat. 205, Sec. 52). It was amended in 1927, again in 1929 and finally in 1939. Of course, the defendants are right in their contention that in 1947, when this suit was brought, there was no such law as that enacted by the amendment of 1929 because another amendment had been made in 1939, and Title 35, Section 63, U. S. C. A., as changed by the 1939 amendment was then the law. After the 1939 amendment became effective there was no reason to refer to the amendments of 1927 and 1929 when pleading the statute, in seeking to apply its provisions to acts occurring subsequent to its effective date. It seems to me that it was entirely unnecessary for the pleader, in referring to Title 35, Section 63, U. S. C. A., (Rev. Stat. 4915), to add the explanatory words as to when the act had been amended. Such language was simply surplusage. It was not even necessary to confer jurisdiction on the court to mention the section of the statute under which it was brought. If the allegations of fact in a complaint show jurisdiction in the court, nothing else is necessary. Should a pleader merely mention the statute as a [fol. 97] basis for establishing jurisdiction and make no other allegations of fact applicable thereto, then he might be bound by such reference; but that is not the case here. A reading of the pleading clearly shows jurisdiction of the subject matter of the suit in the District Court.

Next we come to the question of whether it was necessary for the pleader to quote the words of the statute providing when suit may be brought by an applicant who had been denied a patent. Section 63 (supra) provides that:

> "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant * * * may have remedy by bill of equity, * * *"

Defendants cite no authority to sustain their contention. I do not believe it was necessary to quote the language of the statute in the complaint. The words are simply explanatory of the conditions which authorize the losing party to institute a suit in the District Court and are not jurisdictional. No particular words are necessary if the general allegations show that the Board of Interference Examiners has decided against him—that is, the allegation that the Commissioner of Patents (the only one who could grant a patent) had refused to do so would be sufficient. Under such circumstances the bringing of the action would clearly express dissatisfaction with the action of the Board of Interference Examiners. I think the allegations of the original complaint clearly stated a cause of action, the jurisdiction of which was in the District Court. The amendment was unnecessary, but having been made, it simply stated more clearly and spelled out in greater detail that which was already sufficient. In view of the foregoing the motion of the defendants to dismiss for lack of jurisdiction is overruled.

The defendants next contend that:

> "Findings of the Patent Office Tribunal may not be set aside in these actions, in that not all the evidence on which they were made were presented to this court."

As heretofore stated, plaintiffs did not introduce all of the evidence which had been submitted to the Patent Office [fol. 98] Tribunal. Defendants cite many cases to sustain their position, but with few exceptions they are cases where the court was reviewing the action of some governmental agency rather than trying the case de novo as we are here. It seems to me almost inconceivable that in view of the wording of the statute this court cannot proceed to a determination of the suit upon such evidence as is submitted to it, either all or any part of that which was before the Patent Office Tribunal. The statute is clear and unambiguous. It provides:

> "In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted *in whole or in part,* on motion of either party, subject to such conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, *or parts thereof,* of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit." (Emphasis supplied.)

The language concerning the introduction of the testimony and exhibits before the Patent Office first appeared in the 1927 amendment. Prior to that amendment the statute was silent as to procedure before the District Court. Clearly, it was the intent of Congress that the parties might introduce the whole or any part of the evidence heard by the Patent Office Tribunal for consideration and it is to be given *"the same force and effect as if originally taken and produced in the suit."* (Chapter 273, Sec. 11, 44 Stat. 1336, March 2, 1927).

Next should be considered defendants' contention that:

> "In a suit under R. S. 4915, parties may not introduce new evidence without showing that the evidence was not available for presentation to the Patent Office Tribunal."

At the trial of this suit, plaintiffs introduced the testimony of Clyde R. Paton and Gilbert D. Williams who testified to certain facts concerning the construction and use of the device in controversy. Their testimony was not before the Patent Office Tribunal. It is their testimony to which the defendants object. Defendants cite a number of decisions to sustain their contention and while there may be some conflict of authorities, again, the statute seems to be per-
[fol. 99] fectly clear. The right is given to the parties *"to take further testimony."* Apparently, where the courts

have excluded "further testimony" there has been some special reason for doing so as in Barrett Co. et al. vs. Koppers Co. et al. (22 Fed. 2nd. 395), where the withholding of evidence before the Patent Office was willful. In the Barrett case the witness refused to answer questions before the Board of Interference Examiners and later testified in court to the same facts concerning which he had refused to testify before the Tribunal. There is no evidence here of withholding or concealing the testimony of the witnesses from the Board. Plaintiffs' application had rested in the Patent Office without final action from 1932 until 1940, 8 years before the first of these interferences, No. 78,345, was declared with defendant Henning's application; then in 1943 the second [interferences], No. 80,733 was declared with the defendant's application for reissue of the Ericson patent. The development of the device and its alleged reduction to practice occurred in 1928 and 1929.

The witnesses *were available* and their testimony *could have been obtained* for submission to the Board; but there is no substantial suggestion that their testimony was concealed or deliberately withheld. The war was on and those engaged in mechanical production were busy. Plaintiff testified, and it was undisputed, that he had not talked to these witnesses for many years prior to the hearing. This contention is ruled against defendants.

Next we come to the final and more difficult question: were plaintiffs the first to conceive and reduce to practice the device which is the subject matter of the interference and of this suit? The Board of Interference Examiners found that plaintiffs' evidence with respect thereto was not corroborated and therefore decided against him. We are not hearing this suit on appeal or simply reviewing the record of the Patent Office for errors. We are trying it de novo and the court must make its findings and come to its conclusions from the evidence introduced in this suit and decide it as *"the facts in the case may appear"*. In reaching a decision, the court must keep in mind the principle laid down in Morgan vs. Daniels, 153 U. S. 120, that

[fol. 100] the decision of the Patent Office is controlling upon questions of fact unless the contrary is established by testimony which in character and amount carries thorough conviction. That case was decided long before the amendment which authorized the introduction of the whole or any part of the evidence before the Board and which authorized the introduction of other evidence before the court. This principle is still recognized by the courts. (Minnesota Mining and Mfg. Co. et al. vs. Carborundum Co. et al. 155 Fed. (2) 746). So this court must review the weight of the evidence before it, keeping in mind the presumption of correctness of the Board's ruling and that the burden is upon the plaintiffs to show by strong, cogent and convincing evidence sufficient to carry thorough conviction that they are entitled to priority. The doctrine requires more convincing proof than in the ordinary case, not beyond a reasonable doubt but certainly more than the mere burden of proof. I am not quarreling with the doctrine; but in arriving at its findings and conclusions, having in mind the doctrine aforesaid, the court will apply its own rules for the consideration of evidence and not rules which apparently are followed by the Patent Office, particularly with respect to corroboration. I know of no rule of law which requires the court to require corroboration where the evidence is otherwise sufficiently convincing whatever the degree of proof may be. In other words, it is not necessarily the greater number of witnesses testifying, but such evidence as is more satisfying and convincing to the court whether it be one or a dozen witnesses. It is not, of course, an uncommon thing in a trial of a case before a jury or the court for one or two witnesses to be far more convincing than the testimony of a dozen witnesses on the other side. After all, the final decision of the court, its findings and conclusions, are *its* findings and conclusions and the decision is based upon the evidence before it. If, upon a consideration of the evidence before it, that which was before the Board and new and additional evidence, the court

is thoroughly convinced that the plaintiff was the first to conceive and reduce to practice the patent, then its decision should be for the plaintiffs. If such evidence [fol.101] is not so convincing, then, of course, its findings and conclusions and its decision should be for the defendants regardless of what the Patent Office Tribunal may have done. As I understand the rule, the only distinction between this and any other case is that of the burden of proof. In this case a higher degree of proof is required than in the usual case. So, bearing in mind throughout this burden of proof of thorough conviction, we may forget the findings and conclusions of the Patent Office Tribunal and ask the question of ourselves: does the evidence before us carry thorough conviction?

The defendants insist that if there is any rational basis for the Board's findings they cannot be disturbed by this court. If that contention is true, then this court could not consider anything except the evidence before the Board. This suit would be in the nature of an appeal for a review of the record of the Patent Office Tribunal and not a trial de novo. The statute would be meaningless. The question of whether it is a trial de novo and of whether additional evidence may be received and the matter decided by the court upon the evidence before it has been decided in this circuit in Larson vs. Crowther, 26 Fed. (2) 780, CCA 8, affirming Judge John B. Sanborn while he was a District Judge for the District of Minnesota. The case was decided before the 1927 amendment. On page 783 the court said:

> "The right exists in Crowther, notwithstanding that decision, to have determined on competent evidence in an equity proceeding in a Federal Court the question of whether his application for patents should have been allowed."

(See also, International Standard Electric Corp. vs. Kingsland, Comm'r of Patents, 169 Fed. (2) 890, Minnesota Mining and Mfg. Co. et al. vs. Carborundum Co., et al. (supra).)

This disposes of the questions of law raised by the parties and brings us to a consideration of the evidence and the facts the evidence discloses.

The defendants Ericson and Henning and the plaintiffs Jorgensens all filed their applications for patents within a comparatively short period of each other. Ericson's ap- [fol. 102] plication No. 573,418, was filed on November 6, 1931; Henning's application No. 575,577 was filed on November 17, 1931; and Jorgensen's application No. 585,510 was filed on January 8, 1932.

The application of Ericson No. 573,418 filed November 6, 1931, was acted upon and Patent No. 1,915,851 issued on June 27, 1933, and Patent Re. No. 22,742 issued April 9, 1946, upon application No. 372,428 for reissue. The application of Henning, No. 575,577, filed on November 17, 1931, was acted upon and Patent No. 2,421,733 was issued thereon on June 3, 1947, after the filing of this suit. The application of the plaintiff Jorgensen was not finally acted upon by the Patent Office until the question of Interference with defendant Henning's application and later of reissue of defendant Ericson's patent came up, although Jorgensen's application was filed on January 8, 1932. Before the time of Ericson's application for a reissue, the interference was declared by the Patent Office, Interference No. 78,345 with respect to the Henning application, and later Interference No. 80,733 with respect to the Ericson application.

The Board of Interference awarded priority to Ericson and Henning on October 31, 1945, and upon a reconsideration adhered to their original finding.

Plaintiff Clarence H. Jorgensen and his father, who died in 1933, were engaged for many years in mechanical promotional work largely in the automotive field. They had been engaged in the manufacture of gasoline engines, both stationary and automotive. They had designed a carburetor but had not manufactured it. For many years (as is well remembered by all of us who lived before the modern automotive age) cars were equipped with manually operated

chokes. As early as 1913 or 1914 the Jorgensens had designed a primer pump for injecting gasoline into the intake manifold of an engine as a starting device. This was represented by patent No. 1,457,033, filed January 7, 1921. They continued to experiment with this type of device and particularly with the idea of an automatic choke device. In 1926 patent No. 1,745,622 was filed for a [fol. 103] device to control the water temperature in an automobile engine. Many years—17 or 18—had elapsed between the beginning of experiments and the trial of these suits, and the time when certain events were alleged to have taken placed was filed by the happening of certain other events in relation thereto.

Plaintiff's testimony, if taken as true, tends to show that their device was tried out on a Buick automobile in 1927. He fixes the time by the birth of his twin sons on November 15, 1927, (an event not likely to be forgotten by any father) and by his attendance with one of the other witnesses at the Notre Dame-Southern California football game on November 26, 1927. His device was a primer and provided an automatic device for supplying a rich mixture direct to the intake manifold upon starting, the rich mixture being cut off after the engine had started and had reached operating temperature. Plaintiffs say this device was in operation from October 1927 until August 1928. At that time the Buick car to which the device was attached was sold and the device removed. The evidence tends to show that the device operated satisfactorily in cold weather during that period. This fact is testified to by plaintiff, by Mr. Kyser who operated the car and saw it in operation, and by Morris Gray, a mechanic, who installed it on the Buick. This device was lost after its removal from the Buick and could not be produced either at the interference hearing or at the trial of this suit. In view of later developments I think we may forget this device except as it indicates the theory of the device which the plaintiffs were attempting to develop.

Following the disposition of the Buick car in August 1928, the Jorgensens acquired a Studebaker on October 20, 1928. Kyser and Clyde R. Paton who were connected with the Studebaker Company were instrumental in obtaining the Studebaker for the Jorgensens at wholesale price. Almost immediately after receiving the Studebaker, Jorgensen installed the choke control mechanism on it. All of the witnesses, Jorgensen, Paton, Kyser and Gilbert D. Wil-
[fol. 104] liams testified that the device worked satisfactorily. Paton and Kyser were automobile engineers, and Williams was an experienced automobile mechanic. At the time these tests were made, the Studebaker was equipped with a Schebler carburetor. Later, when the 1929 model Studebaker came out they were equipped with Stromberg carburetors and the Jorgensen car was then equipped with such a carburetor and their device attached to it. Improvements had been made in the meantime. The device remained on the car until July 1930 when the Jorgensens no longer had possession of the car at which time the device was removed. The witnesses whose names have heretofore been mentioned all followed the operation of the device and testified to its effectiveness. Nothing seems to have been done with the device between July 1930 and the time of filing the application for a patent in January 1932. Jorgensen became interested in other developments and plaintiff says that the automotive industry was not yet ready for such a device. That does not quite explain why an application for a patent was not filed, particularly when the developers of the device were engaged in mechanical development and were experienced in that field. The device used upon the Studebaker was demonstrated in December 1943 in the presence of the parties to this suit in temperatures of 22° F. and proved to be satisfactory.

Defendant does not contend that his patent was reduced to practice prior to the filing of his application. The Patent Office Tribunal gives to Ericson the fall of 1929 as the earliest date of conception. That is unimportant as

there was no reduction to practice by Ericson. Defendant has no evidence to disprove the evidence of the plaintiffs except that time must have dimmed the memory of the witnesses and that their testimony should not be believed, and that it falls short of being convincing in that degree required by the law.

As heretofore stated, all of the witnesses were engaged in the automobile industry and interested in its development. They were men of experience in their field and their in [fol. 105] tegrity is unquestioned except to the extent that their memories could not be expected to retain the facts so long a time. While the demonstration before the Patent Office hearing of itself may not be conclusive as to the success and reduction to practice of the device in 1928 or 1929, certainly it is strong and persuasive evidence of its effectiveness while it was being tested in 1928 and 1929. This evidence connected with the other evidence as to its use, is convincing.

Defendant contends that taking plaintiffs' evidence as true it still does not meet the requirements of the law. With this contention I cannot agree. A careful weighing of all the evidence which was presented to the Board of Interference Examiners and which has been submitted to this court carries thorough conviction which is required by the law, that is, that plaintiffs conceived and reduced to practice their patent in 1928 and 1929 prior to the filing of defendant's application. As heretofore suggested, plaintiffs' reason for not having filed their application for a patent until 1932 seems to the court to be without merit. Plaintiffs having reduced their patent to practice laid it aside and did nothing further about it until after the filing of defendant's application. Were it not for the fact that under the law the plaintiffs once having reduced their patent to practicable application are not required to be diligent in filing an application, I should not hesitate to hold that the plaintiffs were lacking in diligence in the filing of their applica-

tion; but that seems to make no difference and the court bows to superior judicial authority.

The Commissioner of Patents, so far as the question of priority is concerned, should be authorized to issue a patent upon plaintiffs' application. It Is So Ordered.

R. M. DUNCAN.

Dated this 31st day of December, 1948.

Opinion of District Court in Clarence H. Jorgensen, et al. v. Otto Henning, et al.

[fol. 34] (Memorandum Opinion in Case No. 4544.)

In the United States District Court for the Eastern District of Missouri, Eastern Division.

Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator, and General Motors Corporation,
Plaintiffs,
vs.
Otto Henning and Carter Carburetor Corporation,
Defendants.
} No. 4544

This is a suit brought under Title 35, Section 63, U. S. C. A. (Revised Statutes, Sec. 4915) to authorize the Commissioner of Patents to issue a patent embodied in the claim, which was the subject matter of an interference proceeding before the Patent Office, to the General Motors Corporation, assignee of plaintiffs Clarence H. Jorgensen and Clarence H. Jorgensen, Administrator, pursuant to application No. 585,510, filed January 8, 1932.

For the purpose of trial this suit was consolidated with the case of Clarence H. Jorgensen et al. v. George R. Ericson et al., No. 4545, in which a memorandum opinion has been filed this day. The facts and the law in the Ericson case are applicable to this case. The interference proceeding before the Patent Office was heard in this case and in the Ericson case at the same time and the court's findings of fact and conclusions of law with respect to the patent in controversy are the same as in the Ericson case. It is so ordered.

The parties may submit findings of fact and conclusions of law in accordance herewith.

R. M. Duncan,
District Judge.

Dated this 30th day of November, 1948.

Opinion of United States Court of Appeals for the Eighth Circuit in Ericson, et al. v. Jorgensen, et al.

[fol. 1044] (Opinion in Cause No. 13,970.)

United States Court of Appeals
For the Eighth Circuit.

No. 13,970.

George R. Ericson and Carter Carburetor Corporation,
Appellants,
vs.
Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator, and General Motors Corporation,
Appellees.

Appeal from the United States District Court for the Eastern District of Missouri.

[January 26, 1950.]

Mr. Hugh M. Morris (Mr. Bertram H. Mann, Jr., and Mr. George R. Ericson were with him on the brief) for Appellants.

Mr. John H. Bruninga (Mr. Alex F. Baillio was with him on the brief) for Appellees.

Before SANBORN, WOODROUGH and RIDDICK, Circuit Judges.

WOODROUGH, Circuit Judge, delivered the opinion of the Court.

This appeal is taken from the judgment rendered by the District Court pursuant to and in accordance with its opinion which is reported at 81 F. Supp. 614 and is here referred to in entirety to avoid repetition. As stated in the opinion, the action was brought by bill in equity under Revised Statutes Sec. 4915, Title 35 U. S. C. A. Sec. 63, to ob-

tain a decree authorizing the Commissioner of Patents to issue a patent including a claim which was the subject matter of an interference proceeding before the Patent Office, to the General Motors Corporation, assignee of the plaintiffs Clarence H. Jorgensen and Clarence H. Jorgensen, Administrator, pursuant to an application of the Jorgensens for patent filed on January 8, 1932. A similar action was brought at the same time to authorize issuance of patent embodying other claims also in interference to the same assignee pursuant to Jorgensens' same application. The Board of Interference Examiners had heard the two interferences together and had decided adversely to the claim of the Jorgensens in each and had awarded priority of invention to George Ericson in one and to Otto Henning in the other. As shown in the court's opinion, above cited, the two civil actions were tried at the same time and two opinions were handed down, the other being reported at 81 F. Supp. 621. The separate judgment of the court in each case was contrary to the decision of the Board of Interference Examiners and was to the effect that the Jorgensens were first and original inventors prior to Ericson and Henning. Each judgment authorized the Commissioner of Patents to issue patent to Jorgensens' assignee. Separate appeals on a single record are taken to reverse the judgments and we consider first the judgment entered pursuant to the opinion reported at 81 F. Supp. 617. It adjudges that the Jorgensens were entitled to be awarded priority of invention against Ericson in respect to the single count which was a claim of the Ericson patent adopted for the purpose of interference under the Jorgensen Application and involved in the interference and directs decree authorizing the Commissioner of Patents to issue patent including that count to the assignee of the Jorgensens.

The trial court said (p. 616): "As the common subject matter of the claims embodied in the interference proceedings were determined by the Patent Office, I see no reason for a more detailed description of the patents or claims in

controversy" and it is clear from the whole record that the sole fact question which was put in issue and tried out and adjudicated in the trial court was whether or not the Jorgensens had conceived and reduced to practice their certain identified device called an automatic choke for automobiles at a date prior to Ericson's original application filed on November 6, 1931. The defendants' position in that controversy was that the device produced and relied on by Jorgensens as to their prior invention was not conceived and reduced to practice prior to the date of Ericson's application and that it was merely one of numerous experimental combinations assembled by the Jorgensens in the course of their efforts to "find means that would sense the requirements necessary to start and run an automobile engine particularly when cold, entirely automatically", and that the Jorgensens had concluded as early as August, 1930, some eighteen months before they filed their patent application, that their device was ineffective and that it became merely an abandoned experiment affording no basis for the issuance of patent. In response to that issue, after considering the device itself and all that related to the conception, construction and reduction to practice, the court declared that its careful weighing of all the evidence "carries thorough conviction which is required by law that plaintiffs conceived and reduced to practice their patent in 1928 and 1929." The judgment according priority to Jorgensens was rested upon the "thorough conviction" so arrived at and declared by the court. As shown in the opinion, the questions of law raised by defendants were ruled in favor of the plaintiffs.

On this appeal it is contended for appellants for reversal (1) that the evidence was insufficient to sustain the judgment; (2) that the plaintiffs failed to present to the court all the evidence that was before the Board of Interference Examiners, and introduced evidence not submitted to the Board and thereby made it impossible for the court to adjudicate priority of invention contrary to the award of

priority made by the Board; (3) that the Jorgensens lost any right to patent they may have had by delay in applying for patent, and (4) that the complaint before it was amended failed to state facts necessary to confer jurisdiction, and that the amendments erroneously permitted to be made after the six month period fixed by the statute for commencement of the action did not cure the defect or confer jurisdiction.

In a reply brief for appellants a further argument is here presented to the effect that the device relied upon by the Jorgensens and claimed by them to have been reduced to practice prior to the date of Ericson's application as found by the court was in fact merely an indefinite and unstated combination of insufficiently described elements and did not embody the subject matter of the count in interference. But it appears from the record that the issue thus sought to be raised was not presented to, tried or decided by the trial court. As hereinafter stated, we hold that the bill in equity as amended presented a case within the jurisdiction of the court brought under Section 4915 to obtain authorization for patent upon review and avoidance of the decision of the Board of Interference Examiners which determined that the Jorgensens had not reduced their identified device to practice prior to Ericson's application date. The case in the Patent Office arising out of Jorgensens' and Ericson's patent applications had gone in due course of Patent Office proceedings to the Board of Interference Examiners from decisions and rulings of the primary examiner by which the questions of invention, embodiment thereof in claims and the common subject matter of the claims were established for the purpose of the interference. Although the opinions of the Board do not expressly so declare, it is evident from their context that the Board accepted the rulings that preceded the interference and tried out and decided the question of priority. They show in reference to one element of "Jorgensen et al." (a so-called "kicker") that Ericson "moved during

the motion period" "to dissolve the interference on the ground that Jorgensen et al. (1) did not disclose the subject matter of the count" but the Board agreed with the position of the primary examiner on that matter and it records no other objection raised by Ericson to any failure of "Jorgensen et al." to embody the subject matter of the count in interference. The "kicker" was not disclosed in the device exhibited and relied on in the civil action.

In that action the plaintiffs' evidence went to show that the Board decided erroneously and defendants sought to sustain its decision in their favor but neither party at any stage of the trial questioned the validity of the action of the patent office declaring the interference. Although the findings prepared by counsel to reflect the court's opinion included a finding that Jorgensens' "choke controlling mechanism embodies the subject matter of Count one" of the interference, the appellants have not assigned that finding as error in their appeal.

We think the trial court properly recognized the validity of the interference for the purposes of the suit in the absence of issues in respect to it and limited its decision to the issue of priority litigated before it.

We need not and do not hold that in an action brought under Section 4915 the court may never inquire into and determine that neither party is entitled to a patent for want of invention or for want of valid or appropriate claim. *Morgan v. Daniels,* 131 U. S. 120 establishes the contrary. But in this case the proceedings in the Patent Office after the application for patent was filed, which led up to and established the existence of interference cognizable by the Board of Interference Examiners, are not before the court. Although the device relied on is a little gadget that was manufactured in quantity for about fifty cents, the questions as to invention and embodiment thereof in claims are not frivolous. They arise in the very active and crowded art of carburetors and valve controls related to carburetors and in the absence of issues properly defined and

litigated in respect to them and understanding of the considerations that have governed the action of the Patent Office, the court may not disregard that action. As settled by the Supreme Court in *Hoover Co. v. Coe,* 325 U. S. 79, the action under Section 4915 may be maintained to correct any erroneous adverse rulings in the Patent Office which if unreversed would end the proceedings in the Patent Office and result in denial of patent to an applicant. In that case the alleged erroneous decision was that the claims did not accurately describe the disclosure in the application; here it was that priority had been erroneously awarded.

Our review is accordingly limited to the matters litigated and decided in the trial court.

Opinion.

(1) As to the sufficiency of the evidence. We think the evidence that the Jorgensens made their automatic choke device and attached it to their Studebaker car with Stromberg carburetor and tested it out and found that it worked satisfactorily through the winter of 1929 and 1930 fulfills the requirement set forth in the opinion of this court in *Larsen v. Crowther,* 26 F. 2d 780, and "carries thorough conviction" that they conceived their device and reduced it to practice at that time and prior to the application date of Ericson on November 6, 1931. We have carefully considered the particulars of testimony pointed out by appellants and relied upon to sustain their contention to the contrary. It is true that Jorgensen made an entry in his personal records immediately after taking the device off of the Studebaker car and laying it aside in August 1930, which included statements which might be taken to indicate that he then thought the device would not work in starting a car and that other elements than those employed would be necessary. Also that on the same date the Jorgensens had signed and caused to be notarized a drawing showing a manually operated element connected with the linkage of their device to adjust it to control the choke valve. It also

appears that the physically exhibited and relied on device includes two elements not within the claimed invention, namely, a dash-pot and a solenoid, and oral testimony was relied on to show that those elements had been disconnected at relevant times and not used. There was also an invoice said to indicate that Jorgensens received the Stromberg carburetor to which they attached their device at a much later date than they claimed.

But consideration of all contentions made for appellants on the evidence has not persuaded that any fact or circumstances were shown sufficient to raise substantial doubts of the truth of the proof presented that Jorgensens did conceive and made the device they brought into court; that they attached it to a Stromberg carburetor on a Studebaker car sometime before Christmas 1929, and ran the car with it through the winter of 1929-1930. That during that time they demonstrated the device and its operation to witnesses who were especially qualified to and did understand and appraise it and that it worked successfully. We find none of the so called documentary evidence relied on by defendants to be unequivocal or demonstrative that the Jorgensens thought their device would not work or that they abandoned it. We need not ignore that automatic chokes remain without universal adoption in 1949, twenty years after Jorgensens produced theirs. An absolute of perfection is not involved. The evidence justified the certain conviction arrived at by the trial court that the Jorgensens conceived and reduced their device to practice long prior to Ericson.

(2 & 3) The points made for appellants that all the evidence taken before the Board was not brought before the court and that the court heard evidence not submitted to the Board and that the Jorgensens lost their right to a patent through their delay in applying for it, appear to be without merit. The provisions of the statute as to the testimony to be received and considered on the trial of an action under

Section 4915 are not ambiguous and in our earlier case of *Larsen v. Crowther, supra,* the decision adverse to that of the Patent Office was arrived at largely because of the testimony brought before the court not previously presented to the Board. The Jorgensens did not delay unduly in applying for patent. Soon after reducing their invention to practice they contracted to have patent applied for and for manufacture and commercial exploitation and upon failure of the other contracting party to proceed they took other steps to the same end and actually applied well within two years. In the years 1934 and 1935 some three or four hundred thousand units of their device, substantially like the original, were turned out.

(4) As to the jurisdiction: It appears that in drawing the bill in equity herein a mistake was made in describing the statute, Section 4915 under which it was brought, in that the pleading failed to include reference to the amendment to that section of 1939 or the allegation contemplated by that amendment that the plaintiffs were "dissatisfied with the decision of the Board of Interference Examiners." The bill set out that the Board had tried out the interference and that it had decided priority in favor of Ericson and against the plaintiffs, whereas the plaintiffs were in truth the first and prior inventors entitled to priority over Ericson. It alleged that the Commissioner of Patents had refused them a patent and prayed that he be authorized to issue one.

We think it was clearly to be inferred from the allegations of the bill as it was filed that the complaint or dissatisfaction of the plaintiffs was on account of the decision of the Board awarding priority of invention to another when in truth the plaintiffs were entitled, and so considered it stated a case under the amended statute within the jurisdiction. The ruling of the court permitting amendment to make that meaning certain was not erroneous.

On the whole record we find no error to justify reversal and accordingly affirm the judgment.

Affirmed.

Opinion of United States Court of Appeals for the Eighth Circuit in Henning, et al. v. Jorgensen, et al.

[fol. 1043] (Opinion in Cause No. 13,969.)

United States Court of Appeals
For The Eighth Circuit.

No. 13,969.

Otto Henning and Carter Carburetor Corporation,
Appellants,
vs.
Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator, and General Motors Corporation,
Appellees.

Appeal from the United States District Court for the Eastern District of Missouri.

[January 26, 1950.]

Mr. Hugh M. Morris (Mr. Bertram H. Mann, Jr., and Mr. George R. Ericson were with him on the brief) for Appellants.

Mr. John H. Bruninga (Mr. Alex F. Baillio was with him on the brief) for Appellees.

Before SANBORN, WOODROUGH and RIDDICK, Circuit Judges.

WOODROUGH, Circuit Judge, delivered the opinion of the Court.

This appeal is taken from a suit brought under Revised Statutes, Sec. 4915, Title 35 U. S. C. A. Sec. 63, to authorize the Commissioner of Patents to issue a patent embodied in the claim which was the subject matter of an interference

proceeding before the Patent Office, to the General Motors Corporation, assignee of the appellees, Clarence H. Jorgensen and Clarence H. Jorgensen, Administrator.

The appeal was consolidated with that of George R. Ericson, et al. v. Clarence H. Jorgensen, et al. in which an opinion has been filed this day. The decision in the Ericson case is applicable to this case as the same questions are involved.

For the reasons stated in the opinion in the Ericson case the judgment appealed from is affirmed.

Affirmed.

Judgment of the United States Court of Appeals for the Eighth Circuit in Ericson, et al. v. Jorgensen, et al.

[fol. 1055] (Judgment in Cause No. 13,970.)

United States Court of Appeals
for the Eighth Circuit.

January Term, 1950.
Thursday, January 26, 1950.

George R. Ericson and Carter Carburetor Corporation, Appellants,

No. 13,970. v.

Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator of the Estate of Peter J. Jorgensen, Deceased, and General Motors Corporation.

Appeal from the United States District Court
for the Eastern District of Missouri.

This cause came on to be heard on the record from the United States District Court for the Eastern District of Missouri, and was argued by counsel.

On Consideration Whereof, it is now here ordered and adjudged by this Court, that the judgment of the said District Court, in this cause, be, and the same is hereby, affirmed.

January 26, 1950.

Judgment of the United States Court of Appeals for the Eighth Circuit in Henning, et al. v. Jorgensen, et al.

[fol. 1054] (Judgment in Cause No. 13,969.)

United States Court of Appeals
for the Eighth Circuit.

January Term, 1950.
Thursday, January 26, 1950.

Otto Henning and Carter Carburetor Corporation
Appellants,

No. 13,969. v.

Clarence H. Jorgensen, Clarence H. Jorgensen, Administrator of the Estate of Peter J. Jorgensen, Deceased, and General Motors Corporation.

Appeal from the United States District Court
for the Eastern District of Missouri.

This cause came on to be heard on the record from the United States District Court for the Eastern District of Missouri, and was argued by counsel.

On Consideration Whereof, it is now here ordered and adjudged by this Court, that the judgment of the said District Court, in this cause, be, and the same is hereby, affirmed.

January 26, 1950.

Order Correcting Opinion and Denying Petition of Appellants for Rehearing in Ericson, et al. v. Jorgensen, et al.

[fol. 1093] (Order correcting Opinion and denying Petition of Appellants for Rehearing in Cause No. 13,970.

March Term, 1950.
Friday, March 31, 1950.

On Consideration of the petition for rehearing herein it is ordered that the opinion of January 26, 1950, be corrected as follows:

1. For the word "reissue" appearing on the 17th line of page 3 (Clerk's printed copy) substitute the word "original."

2. For the date "August 1929" appearing on the 8th line from the bottom of said page 3 substitute "August 1930."

3. For the date "August 1929" appearing on line 18 of page 7 substitute "August 1930."

Upon such corrections being made, It is Ordered that the petition be and it is hereby denied.

March 31, 1950.

Order Denying Petition of Appellants for Rehearing in Henning, et al. v. Jorgensen, et al.

[fol. 1092] (Order denying Petition of Appellants for Rehearing in Cause No. 13,969.)

March Term, 1950.
Friday, March 31, 1950.

On Consideration of the Petition for rehearing filed by the appellants in this cause, It is now here Ordered that the same be, and it is hereby, denied.

March 31, 1950.

Office - Supreme Court,
FILED
JUN 29 1950
CHARLES ELMORE CROP
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1949.

No. [redacted] 74

GEORGE R. ERICSON and CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

No. 822.

OTTO HENNING and CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

RESPONDENTS' REPLY BRIEF.

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